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IN THE

Supreme Court of the United States

OCTOBER TERM 1963

No. [redacted] 146

BRYAN W. NICKERSON, JR.,

Petitioner,

vs.

THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered December 28, 1962.

OPINIONS BELOW

The District Court did not write an opinion but the Court's Findings of Fact, Conclusions of Law, and Judgment are part of the record before the Circuit Court of Appeals in the Appendix to Brief of Appellants on pages 139A, 143A, and 147A respectively. The opinion of the Circuit Court of Appeals is printed as an Appendix to this petition. No petition for a rehearing was made.

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254 (1) On March 26, 1963 Mr. Justice Stewart signed an order extending the time to file a petition for a writ of certiorari in this case to and including May 27, 1963.

JURISDICTION OF COURTS BELOW

This is a suit for patent infringement. Jurisdiction of the Federal Courts is founded on 28 U.S.C. Sec. 1338 and 1400.

CONSTITUTIONAL PROVISION, STATUTES, AND RULES INVOLVED

Article III, Sec. 1 of the Constitution of the United States:

> "The judicial Power of the United States, shall be vested in *one* Supreme Court, and in such inferior Courts as the Congress may from time to time ordain and establish."

U.S.C. 35, Sec. 251: Reissue of defective patents (First paragraph)

> "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. *No new matter shall be introduced into the application for reissue.*" (Emphasis supplied.)

U.S.C. 35, Sec. 114. Models, specimens.

> "The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.
>
> When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment."

Patent Office Rule 91. Models not generally required as part of application or patent.

> "Models were once required in all cases admitting a model as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for."

QUESTIONS PRESENTED

1. Is it acceptable judicial procedure for a Circuit Court of Appeals to decide a case with complete disregard for the truth as found in the record, indicating thereby that adequate investigation was never made?[1].

2. Should a Circuit Court's opinion stand unreviewed that supports the premise that the patent grant be discriminately available only to those financially able to spend huge sums of money to develop and test the subject matter of the

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1. It should be noted that if a writ of certiorari is granted this case will be argued on the questions of validity and infringement on which the Circuit Court erred as a result of the above departure from propriety in deciding this case. Questions above and especially Question 1 are reasons why your Petitioner feels that a review by the Supreme Court is justified.

patent, and establish a criterion for patentability that is inequitable, unrealistic, and contrary to the law?

3. Can courts use words of a Primary Examiner in the Patent Office to support court's erroneous conclusions in invalidating a patent, when said words were subsequently found erroneous and were reversed by the Board of Appeals, and when said practice would, in effect, destroy an effective line of appeal in the Patent Office?

STATEMENT

Your Petitioner, Plaintiff, sued in the Trial Court Respondent, Defendant, Bearfoot Sole Co., Inc., et al, for infringement of Petitioner's patent No. Re. 24,518,[3] herein referred to as Petitioner's patent. Defendants, Bearfoot, were producing articles of manufacture as per Plaintiff Exhibits No. 1, 3, 5, 7, 9, of which Exhibits No. 2, 4, 6, 8, 10 are cross-sectional cuts thereof. The foregoing exhibits together with Plaintiff's Exhibit No. 26 are transferred to this court herewith. (Exhibits 1 thru 10 stipulated, see Appendix 12A)

Defendants are licensed and operating under Barnes Patent No. 2,621,979,[4] herein referred to as Barnes No. 1. Defendants claimed in defense that Petitioner's structure was inoperative, that claims 1 and 2 were not patentable over Barnes, Spencer[5] and Daniel.[6] Defendants also argued that reissue claim 3 was improvidently allowed and on infringement contended that Plaintiff Exhibits 1, 3, 5, 7, 9

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2. Guide regarding references of record. Appendix, followed by page number and letter A designates page in Appendix of Appellants in Circuit Court. Decision, followed by page and key number, designates location in the decision of the Circuit Court.

3. Appendix 81 A

4. Appendix 109A

5. Appendix 107A

6. Appendix 123A

used a different mode of operation than distortion by the inflated tire.

The suit was brought in the United States District Court for the Northern District of Ohio, Eastern Division. A judgment was filed February 9, 1961[7] in which the Findings of Fact[8] and Conclusions of Law[9] proposed by the counsel for the Plaintiff were adapted. The patent was found valid and infringed.

Defendants appealed the judgment to the Circuit Court of Appeals for the Sixth Circuit and in a decision filed December 28, 1962, the Circuit Court reversed the judgment of the Trial Court.

Facts re. Question 1[10]

Your Petitioner realizes that an erroneous decision, per se., does not necessarily warrant review by the Supreme Court. The very size of the docket necessitates stringent allowance of writs of certiorari. In this present case, however, there is much more involved than matters of opinion that may be flexed broad or narrow, but rather errors that indicate a judicial practice that is not compatible with justice, for how can there be justice when the decision does not reflect the truth? There is not involved here one single spectacular error, but a series of the subtle more dangerous errors that have the cumulative effect of eroding and thwarting justice. What is unbelievable to your Petitioner, a layman, is the fact that a Circuit Court of Appeals, that is expected by the public to exemplify propriety, prudence, and integrity, should issue out a decision so wanting for accuracy and truth. As a lesser example of these inaccuracies, the

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7. Appendix 147A
8. Appendix 139A
9. Appendix 143A
10. Petitioner regrets burdensome nature of comments, but feels they will aid in putting Question 1 in perspective.

Circuit Court reprinted cancelled claims word for word except the one part that really mattered, the patentable life of the claim. The qualifying phrase was omitted; this was compounded when the Court erroneously pointed out another phrase it held to be the qualifying phrase to support still another erroneous contention by the Court.[11]

So that the Supreme Court can better understand the significance of the errors made by the Circuit Court, your Petitioner respectfully asks the Court to read Barnes No. 1 (Appendix 109A) and Petitioner's patent (Appendix 81A). These two documents are the focal points on which the case turns.

The Petitioner's patent relates to an attachable white wall for automobile pneumatic tires.

For years and especially during World War II and the Korean War, when strategic materials precluded making white wall rubber tires, and they all but disappeared from the market, the industry had been *striving in vain* to provide a substitute white side wall. The very best the industry had to offer was a rigid plastic disc, white in color, that snapped onto the wheel—usually overlapping slightly the side wall of the tire—effecting a white wall tire. As soon as white wall tires became available again the white disc soon lost favor with the public. But the demand remained for a feasible, realistic, imitation white side wall that could be detachably mounted and exchanged from tire to tire as the tires wore out or as the owner wished. The demand persisted, however, mostly because to the average lower income automobile owner white side wall tires were priced prohibitively

To fill this need, then, required a side wall easily combined with existing wheel and tire assemblies, that could be made with a minimum of steps permitting a one-step operation, and providing a single molded structure that would assure low cost and mass production.

The one piece structure had to be elastic or resilient in nature so that a flat tire or tire striking the curb would not

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11 See error 12

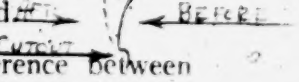
damage the side wall. Being resilient it had to have some means so that it would not flap out but remain inwardly toward the tire. In addition to all this, the side wall should appear to be a real white side wall tire at least from a short distance away. Filling this order, then, was no small chore.

The closest the prior art came to this solution is represented in patents to Daniel, Spencer, and Barnes, all cited as references. Spencer used a rigid construction, Daniel used glue, and Barnes used wire springs imbedded in the side wall running radially inwardly, bending nearly at right angles and projecting axially inwardly (see Barnes No. 1, Fig. 2, numeral 21). This spring and the manner in which it is bent and extends beneath the tire bead is why the Barnes' main body portion can maintain its position. The springs give the body portion a semi-rigid construction.

In this setting then; the need, the nature of the problem, and the state of the art as they all existed in 1951, the present invention was conceived. Conception was not easy. The present invention provided for the *first* time a single piece of resilient material that could be mass produced in one operation. The structure, that by its shape alone and without the aid of auxiliary means would maintain an inwardly pressure and not flap out away from the tire. A structure that provided a side wall that looked like a white side wall tire.

This was accomplished by departing substantially from the teachings of the prior art. The prior art as in Barnes and Daniel disclosed structures that were sinuous in cross section, rigid or semi-rigid in nature, and shaped to conform to the shape of the fully inflated tire as shown in Barnes No. 1 (, or as in Daniel.

The Petitioners' invention has a cross-sectional shape in which the body portion lends itself to being distorted by the inflating tire and due to the resilient properties of the material used resist this distortion. The two main points of departure from the prior art are as indicated.



Therefore the operative and novel difference between Petitioner's invention and prior art was that it had an arcuately shaped cutout 20 which followed the rim flange

12 around.[12] Barnes and Spence did not follow the rim flange around but parted somewhat in a radial direction in a smooth flowing curve.[13] The cutout of Petitioner's structure rested on the rim flange and assured that the body portion took its initial pre-distorted position.[14]

The other patentable and operative feature and departure from the prior art is the cross-sectional pre-distorted shape of the body portion.

If there is any doubt that the Petitioner's patent sufficiently teaches those skilled how to make the invention, please remember that the Defendants made the side wall from the patent and attempted to prove inoperativeness therewith. The District Court and Circuit Court found the structure operative.[15] Operativeness is not an issue here.

There is one aspect of this case that should be clarified, however, and that is the fact that this invention is difficult to disclose in that the invention actualy lies in a shape. The initial pre-distorted, cross-sectional shape of the side wall is in fact the invention. A shape, especially an *irregular* shape, that does not fall into the broad class of circles, squares, etc., is very difficult to put into words. The old saying: A picture is worth a thousand words is applicable here. For this reason the specification has relied in some instances on the drawing to disclose and define the shape.[16]

This could not be done in the claim, however, and claimology phrasing was used. The patentable and operative phrases in claims 1 and 2 are: "side wall being biased outwardly and frictionally embracing the tire when the tire is inflated" is a functional phrase supported by a structural phrase, after establishing the nature of the cutout, which is

12. See Petitioner's patent Fig. 2 and 5; also col. 1, lines 64-72, col 2, lines 36-38.

13. See Barnes No. 1 Fig. 2; also Spencer appendix 107A, Fig. 2.

14. Scientific principles are not required in patent disclosures, but to say that the cutout 20 resting on the rim would act as a catalytic agent between the lip which is anchored and the body portion which is being distorted, may help the Court understand the role and necessity of the Petitioner's arcuate cutout—lacking in prior art.

15. Decision, page 36, key 1.

16. Petitioner's patent, col. 2, lines 64-71

set forth: "cutout defining a hump providing vertex for the outer portion of the side wall." Taking the definition of vertex as found in the dictionary, we see that it is the highest point of the meeting of two sides. Taken in the light of the specification we see that the body portion in relation to the hump is in a position that is axially inwardly of that position it will take after inflation.

In reissue claim 3 the cutout is provided by the lip portion being, "arcuately recessed," and the pre-distorted shape is set out by the phrase: "the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion."

Therefore a novel and patentable invention has been provided, the statutory requirement for disclosure have been satisfied and examined not once but three different times and allowed. A valid patent issued.

In the light of the foregoing, then, let us examine what the Circuit Court said about validity and infringement.

Following are statements (in abstraction) of some of the erroneous holdings of the Circuit Court followed by quotations from the decisions that support these errors. Opposing facts are then pointed out that represent the truth of the case as found in the record indicating thereby that the Circuit Court did not dutifully determine the case on the facts.

Error 1: The holding by the Circuit Court that Barnes No. 1 anticipated the Petitioner's structure and disclosed a structure that lends itself to distortion, said anticipation specifically pointed out in the term: "turned inwardly."

In the decision: Page 8, key 2; page 11, key 3; page 28, key 4.

The truth: The above holding is an adaptation of a self-serving myth developed by the Defendants. Petitioner directs Court's attention to Barnes No. 1 claims 2 and 3 in which following phrase appears: "said annular body having its inner peripheral portion *turned inwardly* to form a skirt . . ." This finds support in the specification in col. 2, lines 4-9, which states: "Fixed securely to or formed integ-

rally with the inner periphery of the annular body 20 is a skirt 21 which is adapted . . ."

Let's review briefly how Barnes overcame the problem of the side wall flapping out. The body portion is provided with flat springs which are bent and turned axially inwardly to be included with the skirt as shown Fig. 2. The side wall and the springs are shaped to conform to the tire[17] and when the tire is inflated the side of the tire comes out to meet the annular body 20. This static relationship is maintained because the wire springs give the body portion a semi-rigid character. The key to this function is the bend in the wire and the fact that the springed skirt is wedged *under* the bead of the tire.

Compare this with the Petitioner's structure that has the cutout resting on the flange 12 and coacting with the body portion which is shaped, not to conform to the shape of the tire, but a pre-distorted shape so that it is distorted by inflating tire and assuming the shape thereof but resisting distortion

Therefore there is not even a remote possibility that Barnes No. 1 patent anticipates Petitioner's invention or that the phrase, "turned inwardly," is analagous to a structure lending itself to distortion.

Error 2: The contention or inference that activity by Defendants prior to the issuance of the Petitioner's patent somehow invalidates the novelty of said patent.

In the decision: Page 12, key 5.

The truth: The filing date of Petitioner's patent was April 24, 1951, and takes precedence over any activity by the Defendants by at least two years. The only possible meaning the Circuit Court's contention could have (which reflects Defendant's argument) is that the invention is obvious to those having *ordinary* skill in the art because they produced it on their own before the patent issued. It was Barnes, however, not Bearfoot who initiated the development of the side wall.[18]

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17. Barnes No. 1, col. 2, lines 2-4.

18. Appendix 32A-33A, Taylor, direct.

The side wall, if developed independently, of the teachings of the Petitioner's patent was conceived and developed by Barnes, the inventor, and not Bearfoot, or those with ordinary skill. It should be noted that Barnes has been granted approximately 5 or 6 patents on attachable side walls alone. So here is a man with an inventor's mind applying all his creative talent to the problem of providing a feasible imitation white side wall. If he solved it at that time it was not because it was obvious.

Another subsequent inventor, acting independently, to arrive at a similar solution does not invalidate the earlier conception as lacking novelty. If this contention by the Circuit Court were not corrected it would in effect invalidate every patent to issue out of interference proceedings in the Patent Office. For what are interferences but a form of trial in the Patent Office to determine who of two or more parties is entitled to a patent? Such proceedings do not endanger the novelty of the invention.[19]

There is another aspect of the case that is pertinent. Shortly after filing the application, Petitioner disclosed the invention to B. F. Goodrich & Co., and several other people. Theoretically, then, anyone could have gained, by indirect means, knowledge of the invention and produced it independently. This is one reason why interference laws exist.

There is a question as to the authenticity of the dates of Bearfoot's prior activity.[20] Mr. Taylor testified [21] that the Port-A-Wall (Barnes' tradename) was first produced about November 4, 1954. Yet Barnes himself stated in a sworn affidavit in the file wrapper of Barnes Patent No. 2,737,422, that:

> "I succeeded in getting production of my type of trim member started in the early part of 1955 . . ."

This discrepancy suggests a fabrication and cast a shadow of doubt on the entire case of Defendant's early activity and should be considered in that light.

19. In *Elliot & Co. v. Youngstown Car Mfg. Co.*, 181F 345, (3rd Circuit) Judge Archbald said: "The result of interference proceedings is not conclusive of invention in subsequent suit for infringement."

20. Appendix 135A, Chronology.

21. Appendix 35A.

Error 3: The holding by the Circuit Court that the patent was allowed on and the patentable novelty existed in the terms: cutout, hump, and flat portion.

In the decision: Page 11, key 6; page 29, key 7.

The truth: As pointed out earlier the patentable features as set forth in claims 1 and 2 were the arcualety shaped cutout defining a hump which provides a vertex for the outer or body portion.

The Circuit Court's comments in this respect are an unqualified adaptation of the argument by the Defendants and show a lack of understanding of the facts.

Error 4: The contention by the Circuit Court that the invention lacked patentable novelty.

In the decision: Page 32, key 8.

The truth: There is a great deal that could be said about this matter of novelty and the citations on obviousness, etc., would fill a volume. The invention disclosed is novel, however, and finds support for this in the law and precedence. Petitioner would like to cite some pertinent facts and cases and comment briefly on them.

As a historical fact and common knowledge to every male who lived and drove an automobile during World War II and the Korean War, white side wall tires all but disappeared from the market due to strategic war material in making of white rubber. This left a huge void and a demand to be filled by the industry. This demand continued, as stated earlier, to satisfy the low income owners. Therefore for twenty years before the solution by the Petitioner the industry strove, with intensified effort through two major wars, to provide a feasible, attachable, white side wall. Prior to the Petitioner's patent not one side wall had been made that used the before and after principle of distortion. Since the patent however, the acceptance of the solution is indisputable.

Judge Learned Hand in the case of *Lyon v. Bausch & Lomb*, 224 F 2nd 530, said:

> "The most competent workers in the field had for at least ten years been seeking a . . . . there had been a

number of attempts, none satisfactory; meanwhile nothing in the implementary art had been lacking to put the advance into operation; when it appeared it supplanted the existing practice and occupied substantially the whole field. We do not see how any combination of evidence could more completely demonstrate that, simple as it was, the change had not been obvious to a person having ordinary skill in the art." (See also *Feedman v. Overseas Scientific Corp.*, 150 Fed. Supp. 394; *Hotchkiss v. Greenwood*, 52 US 284; *Patent Royalties Corp. v. Land-O-Lakes Creameries*, 89 F 2nd 624).

Judge Hand could very well be speaking of the present case the circumstances are so similar. It is worth noting that the industry had general knowledge for attaching and providing a side wall,[22] it had the material, (the art of plastic molding could have provided a flexible plastic just as easily as it did rigid) the only thing lacking was the novel idea of so initially shaping the side wall in cross-section that it lends itself to distortion as provided by Petitioner's disclosure in patent in suit.

The prior art relied on springs, glue, or rigid construction to keep the body portion of the side wall from flapping out. Petitioner's side wall eliminated all of these heretofore necessary elements and achieved a result that was superior to the prior art. It is well established that the elimination of parts necessary to the prior art while maintaining the same result may be invention of the highest order.[23]

In regards to whether or not the Petitioner's invention was obvious to those having ordinary skill in the art, the solution viewed in retrospective always belittles the inventive effort. The Supreme Court in the case of *Goodyear Tire & Rubber Co., Inc., et al, v. Ray-O-Vac Co.*, 321 US 593, said:

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22. British Patent No. 401, 345, Appendix 127A.

23. Walker on Patents, Deller's Edition, page 207, Sec. 39, the case of *Stow v. Chicago* was cited in which Judge Blodgett said: "A construction of a machine, so that a less number of parts will perform all functions of the greater, may be invention of a high order, . . ."

"The fact that, viewed after the event, the means patentee adapted seems simple as such and should have been obvious to those who worked in the field, is not enough to negative invention."

Error 5: The view that the Patent Office Board of Appeals erred in reversing the Primary Examiner in that the Board never noticed that cancelled claim 4 was a combination claim and should have been a bar, instead of cancelled claim 3, to allowance of the reissue claim 3.

In the decision: Page 25, key 9.

The truth: The above is an adaptation of the Defendant's argument that the Board of Appeals made a mistake and *never noticed* that cancelled claim 4 was a combination claim and should have been a bar to a subsequent combination claims. The Board in its first decision[24] mentions the fact that the application was filed containing subcombination and combination claims therefore was well aware of cancelled claim 4. Board did not agree with Examiner that subject matter, "curved inwardly", was a bar to allowance; Board's reason was that now subcombination claims were not obtainable in reissue in view of earlier cancellation.

Error 6: The Circuit Court has expended a great deal of time and words to support the false premise that the term, "turned inwardly," as used in Barnes No. 1; or, "curved inwardly," as found in cancelled claims of Petitioner's patent defines a side wall that has a cross-sectional shape that lends to distortion.

In the decision: Summed up in statements: Page 11, key 3; page 14, key 11.

The truth: The feature referred to as, "turned inwardly," as found in the Barnes No. 1 has been covered in Error No. 1. Petitioner will not burden the Court by repeating it here except to say that the term as used in Barnes No. 1 is so far removed from defining a distortion prone side wall, that one wonders what the Circuit Court had in mind when it adapted this very misleading argument by the Counsel for the Defendants.

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24. Decision, page 24, key 10.

Regarding the "curved inwardly" as used in cancelled claims 3 & 4, this term was applied to the peripheral edge[25] and not the side wall as stated by the Circuit Court.[26]

When the Petitioner's side wall was filed in (1951) white side walls had a radial width that extended beyond the point of widest bulge of the tire.[27] This meant that the peripheral portion or edge would have to curve inwardly to better conform to the shape of the tire. This was also true of the Barnes No. 1 and Daniel who both had peripheries that curved inwardly yet neither structure was distorted by the inflated tire. A peripheral edge curved inwardly, therefore, does not define a structure that lends to distortion. Yet the Circuit Court repeatedly referred to a *side wall* curved inwardly and held that it defined a distorted structure when in truth the phrase of record was *peripheral edge* curved inwardly. The two are not interchangeable.

Error 7: The holding by the Circuit Court that the Defendant's side wall, Plaintiff's Exhibits 1, 3, 5, 7, 9, are physical embodiments of the structure disclosed in Barnes No. 1.

In the decision: Page 6, key 14; page 12, key 15; page 31, key 16.

The truth: A study of the Barnes No. 1 as seen in Fig. 2 shows a cross-section like this . The Defendant's structure as best seen in Plaintiff's Exhibits 2, 4, 6, 8, 10, are shaped like this . The side wall as found in Barnes No. 1 is static, i.e., it does not change shape in being distorted by the inflating tire, but the Defendant's structure does as is plainly noticeable from the exhibits. Further proof is found in Fig. 6 of Barnes later patent No. 2,737,422, (Appendix 113A) in which he clearly shows the before and after distorted position.

Further, the anchoring means of the Defendant's side wall is a radial skirt; the Barnes No. 1 anchor is an axially turned inward skirt held *beneath* the tire bead.

If one were asked to locate the features of the Barnes No. 1 in the Defendant's side wall, he would be hard put to find

25. Decision, page 7, key 12.
26. Decision, page 8, key 13.
27. Petitioner's patent Fig 2.

even one point of resemblance outside of the fact that both structures are attachable side walls.

Error 8: The statement by the Circuit Court that the invention was not recorded until September 26, 1957.

In the decision: Page 23, key 17; page 29, key 18.

The truth: In any reissue prosecution the most stringently kept law by the Patent Office is the one stating: "No new matter may be introduced into the application for reissue."[28]

The essence referred to by the Circuit Court is directed at a comment made by the Petitioner during prosecution of the reissue and is in reference to the qualifying phrase: "body portion defining a plane . . . ," which was the patentable spark for that particular claim 3. This qualifying phrase had support in the original application *as filed*.[29]

The essence then was recorded when filed in 1951 and not 1957.

Error 9: The statement by the Circuit Court that the Patent Office never realized that it allowed the patent, or was actually aware of what the allowance was granted on.

In the decision: Page 29, key 19.

The truth: Having prosecuted a few patent applications, Petitioner is knowing of the fact that in the early days of the prosecution the Examiner will state a great many reasons why the claim should not be allowed, but eventually, if applicant persists and patentable matter is present, the Examiner will allow the claims. In doing so, however, he seldom says why and just lets the allowance speak for itself. It's the old saying that actions speak louder than words.

In addition, the length of time the patent was prosecuted in the Patent Office, the number of times it was examined and re-examined and then reviewed by the Board of Appeals, leaves no doubt as to either the validity or the features responsible for allowance.

Error 10: The presumption by the Circuit Court that Defendant's structure, Plaintiff Exhibits 1, 3, 5, 7, 9, does

28. U.S.C. 35, Sec. 251.
29. Petitioner's patent, col. 3, lines 3-14.

not infringe Petitioner's patent because side walls do not rely on the principle of being distorted by the inflated tire. Rather Court says Defendant's structure uses an entirely different method to keep the side wall inwardly towards the tire. The new mode of operation being called a "lateral connecting bridge."

In the decision: Page 36, key 20; page 38, key 21.

The truth: First the Circuit Court concedes that Petitioner's claims read on Defendant's structure.[30] This leaves the question of whether or not the mode of operation is the same.

It is established in the brief for the Defendants on appeal that Defendant's structure and Barnes Patent No. 2,737,422[31] *are one and the same.* Counsel said:

> "Another Barnes application covering an improved side wall being made by Bearfoot, was filed December 19, 1955, and issued March 6, 1956, as Patent No. 2,737,422."

Referring to Fig. 6, above, if this view were blown up to a realistic size it could very well serve as the cavity mold drawing for Plaintiff's Exhibit No. 1.

Referring again to Barnes No. 2,737,422, Fig. 6, we see the following facts: 1. The skirt follows the rim flange around in an arcuate shape, and functions the same as Petitioner's arcuate cutout. 2. The main body portion has a before and after distortion position as shown by dotted lines in Fig. 6. This is also supported in the specifications by Barnes in the words: (Col. 1, lines 49-54)

> "Another object of the invention is to mold a side wall trim member to an initial shape so that it must be flexed to engage a tire and wheel assembly and to build forces in the trim member holding it resiliently against the tire sidewall."

This feature is further set forth in col. 3, lines 37-46.

The lateral connecting bridge which is supposed to be the new mode of operation was not thought enough of by Barnes

30. Decision, page 38, key 21.
31. Appendix 113A.

to illustrate. (See Fig. 4). This bridge is mentioned in the specification, however, in Col. 2, lines 14-16; Col. 5, lines 4-12, and is clearly defined as a means by which the side wall will bridge over raised lettering on the side of the tire. One could hardly say that this is the major principal of function of the side wall. Actually this disclosure by Barnes places the bridge in the role of a subordinate, secondary function.

Your Petitioner now respectfully asks the Court to study Plaintiff's Exhibits 1, 3, 5, 7, 9, and compare the operative, after distorted condition and shape with that of the pre-distorted shape as found in cross-sectional cuts Plaintiff's Exhibits 2, 4, 6, 8, 10. Also by placing the skirt of one of these cuts between the thumb and forefinger and pushing on the body portion, there is an enlightenment of mode of operation that transcends any number of words.

It is possible that the Defendants improved the side wall by removing a cut of rubber on the inside of the hump to accommodate the evolving shape of the tire casing as in tubeless tires, but there is no support in law or equity that a subsequent improvement invalidates or escapes infringement of the basic prior patent.

Nor does the fact that Defendant's side wall is smaller radially, and terminates inwardly of the widest bulge of the tire. This is merely keeping abreast of trends in white side wall taste.

The modes of operation are the same and infringement is present in this case.

Error 11: The holding by the Circuit Court that the phrases "turned inwardly," "curved inwardly," "defining a plane that is axially inwardly . . .", are all equivalent.

In the decision: Pages 26 and 27, key 22.

The truth: Although the above errors are not directly damaging to the patent's validity, they do infer some adverse points. What is significant about the statements cited above are that they give us an insight into the Circuit Court's mind and may well be the key to most of the errors in the decision.

The Circuit Court has stated that all the phrases are equivalent. If taken literally and given a broad construc-

tion, the phrases may have a similarity, but these phrases are used in patent claims and they must be interpreted in the light of the disclosure of the specification and drawing. Taken in this manner then the phrases have an entirely different meaning and it's quite believable at this point to think that perhaps the Circuit Court never looked beyond the literal meaning of the phrases.

Error 12: (Generally comprising) There are other errors that are in opposition to the truth such as contradictions within the decision itself,[32] misquotes and quotes out of contex.

There is one that is noteworthy that sets the tone of improvidence inherent in the decision. Claims 10, 11, 12, reproduced in the decision, page 20, key 24, completely omitted the patentable heart of the claim. the qualifying phrase. This error is compounded in a statement on page 27, key 25, in which Circuit Court contends that "curved inwardly" was qualifying phrase in lieu of true phrase decision omitted. This second error was to support a third, the false premise that "curved inwardly" defined distortion.

One need only to notice the correlation between the errors cited and the question of validity and infringement to determine whether or not they are crucial.

Facts re. Question 2

This is in reference to the statement by the Circuit Court as found on page 5, key 26, of the decision which infers that an inventor who does not actually produce and test his invention for operativeness does not have a valid patent.

In-opposition:

1. When the inventor discloses his invention he does so on good faith that U.S. Patent Office does not require actual reduction to practice and the application is considered constructive reduction to practice, and sufficient. If after he has disclosed with this understanding, he finds that later a Court invalidates the patent on the grounds that it is a paper patent, then the U.S. Government who *encouraged* him to

32. In decision, compare statement on page 12, key 5, with page 35, key 23.

disclose, has done so under false pretenses. Inventor faithfully relied on the wording of the statute.

2. The Circuit Court states in this same paragraph that Defendants spent a great deal of money. Courts statement about paper patent raises a surprisingly new question in that Plaintiff never expected Court to take this position. Perhaps it is important, then, to establish the fact that the Petitioner was, and is, of low income,[33] and had borrowed money to the limit of his means to have a mold made to provide the side wall. As they often do, the mold proved faulty and Petitioner was forced to look for other means of innovating invention.

Surely the patent grant was not intended to be available only to those wealthy enough to sustain development and testing for this is not equity.

3. At a time when technology and invention are being directed at the depths of the ocean or the far reaches of space, it is unrealistic to insist that the inventor must produce and test for operativeness in order to qualify for protection for his contribution. In many instances, as in the fields above, it would cost millions to produce and be impractical to test the invention.

4. U.S.C. 35, Sec. 114 states: "The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of the invention." Rule 91, of Rules of Practice of the U.S. Patent Office states, that if the specification and drawing disclose how to make the invention,[34] a model will not be admitted unless called for. If a model is not called for it should be safe to presume that constructive reduction is enough. Therefore the statutes are clear, constructive reduction is acceptable if no request is made by the Patent Office to provide a model. In the past the Supreme Court has held that the Courts should be controlled by the language of the statutes.

If the invention is operative and available for licensing, no *further* benefit would go to the public by the inventor producing his invention.

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33. Present annual gross income—highest to date—is approximately $6400.00 for a family of six.

34. Defendants made structure as taught by Petitioner's patent which was found operative by both lower courts.

In regards to constructive reduction to practice, the Supreme Court said in: *The Telephone Cases*, 31 L Ed. 863. (1888)

> "It is enough that he described his method with sufficient procesion to enable the skilled in the matter to understand what the process is . . ."

Facts re. Question 3

The number of times that the Circuit Court has used comments by the Examiner to support its own erroneous contentions are so numerous[35] that it brings into this present case a factor that could have very serious consequences if allowed to remain uncorrected.

The Circuit Court held, and wrongly so, that the phrase, "turned inwardly," or "curved inwardly" defined a structure that lends to distortion. This was the basic error in the Circuit Court's determinations and involved such crucial matters as anticipation and validity. The Circuit Court used the words of the Examiner to lend support and add weight to its findings.

As pointed out earlier, peripheries turned or curved inwardly do not define a side wall that lends to distortion, therefore the Circuit Court's findings were based on a false premise. This is true, also, of the Examiner who was reversed by a second ruling of the Board of Appeals.[36] It is significant to note that the Board consisted of two Examiners in Chief and one Primary Examiner. Regarding matters of patents, then, this is about as experienced and competent as one could find. The actions of the Board of Appeals were for naught, however, and it was the words of the Primary Examiner that were controlling in this case although said words were proven wrong. The potential drawbacks of such a practice by Circuit Court of Appeals are clear as pointed out in the latter part of the following section.

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35. Decision, page 14 and 15, key 27; pages 17 and 18, key 28; page 21, key 29; page 22, key 30.
36. Appendix 99A.

REASONS FOR GRANTING THE WRIT OF CERTIORARI

There is a disconcerting note about the decision of the Circuit Court. When one reads, for example, the decision and makes a superficial examination of the matter, one gets the impression that the Circuit Court had discharged its duty with the upmost prudence. It took almost a year to hand down the decision which numbered thirty-nine pages, and the Circuit Court commented extensively on the file wrapper, etc. It would appear indeed that the Circuit Court had done a very thorough job. But words and time of this nature are relatively easy to come by. What is required is patient research into the documents of record and devotion of time to understand the truth and significance therein when quite often the truth is clouded by the arguments of the counsel. This is not an easy chore and would probably prove frustrating and overtaxing for most men. But judges are not ordinary men. They are expected and intrusted to have the fortitude to expend the effort necessary to render a just decision.

Looking, then, at the decision by the Circuit Court and comparing its findings with the real truth as found in the record, one can only conclude that the Court did not act with propriety. It did not, it could not have, investigated the documents of record adequately, and therein, barring some unforeseen or unknown circumstances, lies the cause for an extremely unbelievable, erroneous decision by a Circuit Court.

To say, for example, that the term, "turned inwardly," as used in the Barnes No. 1 defines a structure that lends to distortion by the inflating tire is wanting for rational logic and defies understanding. And the statement that the Defendant's structure functions under a completely new and different principle than distortion in the face of an examination of Plaintiff's Exhibits 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, is surely indicative of a lack of investigation.

The source of the erroneous findings are quite obvious, for in the areas that are most crucial, the Circuit Court adapted, apparently without question, the arguments by the counsel for the Defendants.

The Circuit Court criticized, subtly, the Trial Court's adaptation of counsel's Finding of Fact and Conclusions of Law in favor of the Plaintiff. Yet the Trial Court had received the facts first hand and the Trial Judge was observed dutifully taking notes throughout the trial. The Circuit Court, relying on the arguments of counsel, without self-determination from the record, reversed the Trial Court.

So now your Petitioner is seeking a final judgment on the truth and respectfully evokes the responsibility of this Court, endowed by its very creation to either sanction or disavow actions taken by the lower Courts of the land. This guardianship of the lower Courts is found in Article III, Sec. 1, of the Consttution which says that judicial power shall be vested in *one* Supreme Court, a concept which is also supported and strengthened by the statutes on jurisdictional review. It is hard for your Petitioner to imagine the Supreme Court, having the responsibility of manifesting the wisdom of the Constitution, approving of the method used by the Circuit Court to adjudge this case.

We must ask ourselves, then, is this to be acceptable as judicial procedure, to rely on the convincibility of the arguments of counsel rather than to seek the truth through self-determination from the facts. Because if it is, the courts would soon be reduced to mere literary reviewers and justice would become a term to describe a grant to those fortunate enough, and eventually powerful enough (for the process would be self-accelerating) to hire the more literarily inclined, astute, and often deceptive counsel. A seed of decline would surely have taken root.

Regarding Question 2, the question of whether or not a valid patent is dependent on actual or constructive reduction to practice, the statutes are clear and the courts should be controlled by the statutes and not try to re-write them. The Supreme Court has recognized this and previously cited the dangers in the courts usurping the responsibilities of Congress.

In a period when technological advance in producing inventions that cannot feasibly be produced and tested, it is *timely* that the Supreme Court set guide lines whether actual or constructive reduction to practice is required for a valid

patent. If actual reduction is called for, the statutes should be changed to concur so that the inventor will not be lulled into a false sense of security when he discloses his invention. There is a definite *statutory conflict* here between the Courts and the Patent Office.

And finally the practice of the Circuit Court using words and arguments of a Primary Examiner to assist in invalidating a patent when said words were wrong and reversed by a Board of Appeals. This may seem petty and trifling, but if this Circuit Court can apply this practice, who can say where it will end. As pointed out earlier the whole line of appeal in the Patent Office is eroded if not the patent system itself. Without an effective line of appeal in the Patent Office *single* Examiners would have the power of patentable life and death over invention. This is fertile ground for corruption and the whole patent system is in danger.

The patent system has been under assault from various quarters, but primarily from intellectuals who deal mostly in abstract concepts. The intellectual community may well be the saving force in this nation, (it was the same type of men that wrote the Constitution) but their criticism to date has not provided a concrete working alternative to the present patent system. For all its faults, the patent and the copyright systems are all we have to protect the fruits of creative mental effort, not to mention the incentive value, and perhaps we shouldn't foresake them at this time for a hypothesis.

To say that decline and decadence would follow this one erroneous decision by the Circuit Court would be an affront to the Supreme Court, but history tells us that downfalls have started less quietly, and if we are ready to ***knowingly*** compromise judicial integrity, it is later than we think.

The question naturally arises which is pertinent: Is there foundation in the foregoing for the above statements, or is the Petitioner being a self-serving alarmist? The Petitioner, of course, is seeking equitable relief, but material things are for naught when the environment for the pursuit of happiness is lost. As a father of four, concern for the future is natural.

CONCLUSION

It is prayed that in view of the foregoing, the Supreme Court will see the need for reviewing this case.

Respectfully submitted,

BRYAN W. NICKERSON, JR.
Petitioner

CERTIFICATE OF SERVICE

I hereby certify that three copies of the above were this day of , 1963, mailed to Ely, Frye, and Hamilton, Everett Hamilton, Bernard C. Frye, and Mack D. Cook II, 2505 First National Tower, Akron, Ohio; attorneys for Defendants - Respondents.

BRYAN W. NICKERSON, JR.

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In The

Supreme Court of the United States

October Term, 1963

No. [redacted] 146

BRYAN W. NICKERSON, JR.,
Petitioner,

vs.

THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,
Respondent.

DECISION OF CIRCUIT COURT OF APPEALS
APPENDIX TO PETITION FOR WRIT CERTIORARI

BRYAN W. NICKERSON, JR.,
Petitioner
227 Filbert Ave.
Elsmere 5, Delaware

No. 14609

UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

BRYAN W. NICKERSON, JR.,
Plaintiff-Appellee,

v.

THE BEARFOOT SOLE COMPANY, INC.,

THE BEARFOOT AIRWAY CORPORATION,
Defendants-Appellants.

APPEAL from the United States District Court, for the Northern District of Ohio, Eastern Division.

Decided December 28, 1962.

Before: MCALLISTER, Circuit Judge, BOYD and THORNTON, District Judges.

MCALLISTER, Circuit Judge. This is an appeal in a patent case in which the court found plaintiff-appellee Nickerson's reissue patent, Re. 24,518, for a side wall attachment for vehicle tires, valid and infringed by the Bearfoot Companies, the licensees of Barnes, under the latter's patent 2,621,979.

The side wall attachments involved in this case are chiefly ornamental, of an elastic material, and are mainly used to give the smart effect of the more expensive white rubber side wall tires, which have been the fashion for some years, as well as to give some added protection to the sides of the tires. When used with the tire, the side wall attachment must cling to the outer portion of the tire, as a practical matter, and, also, to give an attractive appearance, not only to the tire, but to the ensemble of the automobile.

The determining issues on review are whether the claims in appellee's patent are valid and infringed, which, in this case, present also the questions whether there is substantial identity between appellee's side walls and the accused side walls; and, further whether appellee's patent is operable.

The clearest and strongest evidence to sustain Nickerson's patent is to be found in the testimony of Dr. Paul L. Hoover, the expert witness for appellee, who declared that Nickerson, by designing and proportioning the side wall in a distorted shape made it hug the tire; that by molding the side wall so that its unstressed condition was different from its stressed condition, the inherent resilience and internal stress of the side wall would hold it in place without the necessity of springs or other auxiliary means. Appellants contended that Nickerson did no more than make the side wall with an inward bend; that this was old; and that this method was employed in Barnes' patent and in the accused side walls, which were made in accordance with the Barnes' patent, omitting the springs which were deemed unnecessary by appellants, and which were never used by either Barnes or by the appellants in making the molds for the side walls or the side walls themselves.

Nickerson based his principal claim of infringement on the contention that appellants had appropriated his "principle of resiliency," which he claimed was the "spark" or "essence" or "inventive difference" of his invention over the prior art. Other contentions on patentability and infringement advanced by appellee Nickerson in the district court were embodied in his counsel's proposed findings of fact and conclusion of law, all of which were adopted by the district court without change, and without the filing of an opinion.

In these findings of fact the district court, inter alia, found:

> "The plaintiff's side wall is molded to an initial shape (unstressed position) so that as the tire is inflated, the side wall is distorted from its initial shape to an operative (stressed) position, building up forces therein which hold it resiliently against the side of the inflated tire. The plaintiff's side wall has incorporated therein a 'principle of resiliency' which means that the side wall is so shaped that its resilience holds it against the inflated tire.

"Plaintiff's original patent No. 2,691,550 issued with two claims (1 and 2). The reissue patent contains the original two claims, 1 and 2, and also an additional claim 3. Plaintiff's reissue claims 1, 2, and 3 are dominating claims and are directed to the 'principle of resiliency,' which is neither shown or described in the prior patents set forth in defendants' answer.

"The 'principle of resiliency,' as set forth in reissue claims 1 and 2, is defined by the expression, 'said side wall being biased outwardly and frictionally embracing the tire when the tire is inflated'; and in claim 3 by the expression, 'the body portion having an unstressed cross sectional shape defining a plane that is axially inwardly of the operating position of said body portion.'

"The defendants acknowledge that plaintiff's 'principle of resiliency' is the 'spark' or 'essence' or 'inventive difference' of plaintiff's invention over the prior art.

"Defendants manufacture, and sell side walls for tires which comprise a unitary annular body portion and a recessed lip portion the same as plaintiff's side wall. Defendants' body portion and lip portion coact to cause the body portion of the side wall to engage the inflated tire. During mounting, as the tire is inflated, the body portion is biased outwardly from an unstressed position to a stressed position, thereby producing a distortion which is the same as that produced in plaintiff's side wall, which builds up forces for holding the body portion resiliently against the side of the inflated tire. Thus, the defendants' accused side walls have appropriated plaintiff's 'principle of resiliency,' in that their side walls are so shaped that their resilience holds them against the inflated tire.

"There is substantial identity between the plaintiff's and defendants' side walls, as they do substantially the same work in substantially the same way and accomplish the same results.

"The plaintiff's reissue claims 1, 2 and 3 in suit, read directly on the defendants' accused side walls, which means that the defendants' accused side walls

embody the invention claimed in the reissue claims 1, 2 and 3.

"The defendants' accused side walls, Stipulation Exhibits 1 to 10, embody each and every principle of the plaintiff's invention claimed in reissue claims 1, 2 and 3 of the reissue patent and appropriate the substance thereof.

"The defendants have conceded, by statements in their trial brief and by their failure to introduce evidence with respect to the reissue claim 3, that the reissue claim 3 is operative and infringed.

"The reissue claim 3 is not anticipated by the answer patents and particularly by Barnes 1st patent No. 2,621,797; Spencer patent No. 2,573,996; Daniels patent No. 2,334,388, and the British patent No. 301,345 upon which defendants rely, as the 'principle of resiliency' set forth in the reissue claim 3, which is acknowledged by defendants as constituting the 'spark' or 'essence' or 'inventive difference' of plaintiff's invention, is not found in any of these answer patents.

"The 'principle of resiliency' as embodied in the reissue claim 3, which the defendants concede is the 'spark' or 'essence' or 'inventive difference' of plaintiff's invention does not amount to new matter as the same 'principle of resiliency' is clearly disclosed in the original Nickerson specification as well as in the original claims 1 and 2.

"The reissue claim 3 and the original claims 1 and 2 are identical in substance.

"The reissue claims 1 and 2 are operative despite defendants' contention to the contrary, and in assailing this operativeness, defendants have a very heavy burden of proof which they have not sustained by their ex parte tests."

With regard to the above findings, it does not appear that defendants acknowledge that plaintiff's principle of resiliency is the spark, or essence, or inventive difference of appellee's invention over the prior art. They declare that they have never admitted that appellee's "principle of

resiliency," which term, they say, was coined during the trial of the case, is the "inventive difference" of plaintiff's patent over the prior art. Appellants also deny that the reissue claim 3 is operative and infringed.

At the outset it should be remarked that appellee's patent is a paper patent; that no side walls were ever made in accordance with it; that the only attempt by appellee to make side walls following the teaching of his patent was a failure; and that appellants, in following Barnes' patent, or on their own, with the expenditure of much time and money, had successfully made and sold, up to the time of the trial, more than 3,700,000 of their side walls.

We proceed, first, to discuss the claims that appellants appropriated appellee's "principle of resiliency" which he contends is the spark, essence, and inventive difference of his invention over the prior art. This "principle of resiliency" is so repeatedly emphasized in the arguments of appellee's counsel, as well as in the findings of fact of the district court, that we consider it of the first importance to ascertain whether it is the spark, essence, and inventive difference, which characterizes appellee's patent over the prior art, and whether appellants appropriated and infringed it; and because of the long history of the claims in the Patent Office, the complexity of the language used, and, what the appellee contends to be the principal and crucial issue of the case, we are obliged to follow the many windings of the controversy at considerable length.

The case presents a remarkable display of confusion of language, of repetition of claims in differing phraseology, and of chameleon-like nomenclature, under which the same object or process appears, disappears, and reappears in the guise of varied terminology. It is a controversy in which it is always to be remembered that patent rights, or their infringement, are matters of substance, and not solely matters of words; and that there is no magic in a name, or in the mere language in which a claim is expressed.

Barnes' original patent, 2,621,979, under which defendants-appellants, Bearfoot Companies, (herein called "Bearfoot"), were licensed, was filed May 23, 1950, and issued December 16, 1952. In this patent, Barnes claimed a rubber side wall, "comprising an annular body, disposed in confronting relation with respect to the outer side wall of said tire casing, *said annular body having its inner peripheral portion turned inwardly to form a skirt for engage-*

ment and support intermediate said tire casing and said rim, and resilient means carried on the confronting face of said [side wall] for urging the latter into abutting and embracing relation with respect to said side wall of said tire casing." (Emphasis supplied)

The resilient means, mentioned in the above claim of Barnes, were stated, in the specifications, to be set forth and illustrated in the patent drawings, as flat springs shaped to conform to the smooth inner face of the said wall. These springs, according to the testimony, could be of rubber or metal.

14 Bearfoot, the licensee of Barnes, never attempted to make the side wall with rubber or metal resilient springs, because, as was stated on the trial, it regarded the side wall itself, which was made of elastic material and which was turned "inwardly,"—in the language of the claim—as having adequate resiliency to cling to the tire, without the addition of springs.

A year after the Barnes patent (licensed to Bearfoot) was filed, plaintiff-appellee Nickerson filed his original patent on April 24, 1951, which was issued three and a half years later, on October 12, 1954. Between the time of the filing and the time of the granting of the patent, Nickerson had heavy sledding in the Patent Office. Before Nickerson's orginal patent, with two claims, was finally granted, all of the nine original claims were rejected; numerous additional claims were subsequently filed; these additional claims were rejected; they were amended; and rejected again; and finally two new claims, designated as claims 12 and 13, were allowed as claims 1 and 2 of the patent. These two claims are as follows:

> 1. In combination, a wheel, a rim including annular flanges, a tire mounted on said rim, a unitary ornamental annular side wall provided with a central circular opening, the outer peripheral edge of said side wall being of reduced thickness, there being an annular cutout in said side wall adjacent the inner edge thereof defining a lip for insertion between said tire and one of said rim flanges, said side wall having an intermediate flat portion between the lip and outer portion, said lip including a flat portion and an arcuate portion, said cutout defining a hump providing a vertex for the outer portion of the side wall, said

side wall having its greatest thickness at said hump, said side wall being biased outwardly and frictionally embracing the tire when the tire is inflated.

2. The structure as recited in claim 1, wherein said annular side wall is fabricated of a single piece of flexible material, and wherein said side wall is removable from the tire which it embraces.

The File Wrapper of the original Nickerson patent, 2,691,550 is pertinent. A patent should be construed in the light of its history in the Patent Office. There, it appears that the original application of Nickerson embodied nine claims. All of these claims were, as above mentioned, rejected by the Patent Office on February 8, 1952, as being drawn to an inoperative structure. Claims 3 to 9 inclusive were also rejected (even if operative) as being unpatentable in view of prior art.

Since the File Wrapper may be used to interpret the language of a patent, in our view it is relevant to note the original claims made by Nickerson, which were rejected by the Patent Office, and of these, Claims 1, 2, 3, 4, and 7 are set forth in the margin.[1]

---

[1] The above-mentioned original claims made by Nickerson are as follows:

"1. In combination, a vehicle wheel rim provided with annular flanges, a tire casing mounted on said rim, and an annular side wall arranged contiguous to the outer surface of said tire casing and having a lip positioned between said casing and the adjacent flange.

"2. In combination, a vehicle wheel rim provided with annular flanges, a tire casing mounted on said rim, and an annular side wall arranged contiguous to the outer surface of said tire casing and having a lip positioned between said casing and the adjacent flange, said side wall being white and being fabricated of a flexible material.

"3. As a new article of manufacture, an ornamental annular side wall fabricated of a single piece of flexible material and provided with a central circular opening, *the outer peripheral edge of said side wall* being of reduced thickness *and curved inwardly*, there being an annular cutout arranged around the inner peripheral edge of said side wall to define a lip for insertion between the rim flange and tire casing.

"4. In combination, a wheel rim including a web and a pair of annular flanges projecting from said web, a pneumatic tire casing mounted on said rim, a tube arranged in said casing, an ornamental annular side wall fabricated of a single piece of flexible material and provided with a central circular opening, the outer peripheral edge of said side wall being of reduced thickness and *curved inwardly*, there being an annular cutout arranged around the inner peripheral edge of said side wall to define a lip for insertion between the tire casing and rim flange.

* * * * *

It is important to note that Nickerson's original claims 3 and 4, which were rejected by the Patent Office, described a side wall "*curved inwardly.*"

In view of subsequent claims and to clarify an obfuscated area of the case, it is to be here emphasized that Barnes in his original patent had claimed a side wall "having the inner peripheral portion *turned inwardly* to form a skirt for engagement and support intermediate said tire casing and said rim." We do not understand that Nickerson bases his claim to a patent and infringement thereof by Bearfoot, on the ground that Bearfoot infringed by making a side wall "curved inwardly." Barnes, who licensed Bearfoot, as above remarked, had secured a patent claiming a side wall having its inner peripheral portion "turned inwardly." Nickerson in his original claims 3 and 4, in claiming a side wall "curved inwardly," would be copying Barnes, whose patented side wall had its inner peripheral portion "turned inwardly."

After all the original claims were rejected, Nickerson, on July 14, 1952, petitioned the Patent Office to amend his application, as follows:

> "In response to the Office Action dated February 8, 1952, please amend the above entitled application as follows:
>
> "The side wall of the present invention is constructed so that it has a certain amount of stiffness whereby when the tire is inflated the tire causes the side wall attachment to move to the position shown in Figure 2. With the side wall moved out to the position shown in Figure 2, the

"7. In combination, a wheel rim including a web and a pair of annular flanges projecting from said web, a pneumatic tire casing mounted on said rim, a tube arranged in said casing, an ornamental annular side wall fabricated of a single piece of flexible material and provided with a central circular opening, the outer peripheral edge of said side wall being of reduced thickness and *curved inwardly*, there being an annular cutout arranged around the inner peripheral edge of said side wall to define a lip for insertion between the tire casing and rim flange, said lip serving as a means for transferring the forces caused by the action of the tire bead and the opposite and equal reaction set up by the rim flange, said lip serving to resist any forces tending to move the lip laterally from its proper position, the outer portion of said side wall embracing and fitting snugly the adjacent portion of the tire casing." (Emphasis supplied.)

> side wall snugly hugs the tire. Normally the side wall of the present invention has the shape shown in Figure 5, and after it is installed in place and the tire initially expanded by the innertube therein, the side wall 17 moves to the position shown in Figure 4. Finally, with the tube and tire fully expanded or inflated, the side wall 17 occupies the position shown in Figure 2. The side wall of the present invention is made of a rubber-like plastic and is of a sufficient stiffness or resiliency so that it will hug the tire at all times.
>
> * * * * * *
>
> "As the result of a careful review of the entire record of this case, it has been deemed advisable to amend the specification so as to further amplify the construction and use of the side wall attachment of the present invention. The specification, as now amended, quite clearly defines applicant's invention and is solely within the confines of the original disclosure and description."

With reference to the claims, Nickerson stated in the amendment, the following:

> "With reference to the claims, it is submitted that prior to the instant invention it was not possible to provide an ornamental white side wall for attachment to a vehicle tire. *The section 18 is flat and is securely anchored along its inner portion so that the section 18 will only be able to take the shape of the outer surface of the tire casing.* The outer section 19 embraces and fits perfectly that adjacent portion of the tire casing for which it is shaped and designed. Also, the base of the lip 21 on the outside surface serves as a guide and the side wall is flat between the lip and the outer portion, the outer portion being curved inwardly."

In the foregoing amendment, Nickerson set forth why, in his opinion, claims 4 to 9 inclusive of the original application defined invention, as follows: that when the tire was inflated, it caused the side wall to move outwardly, as shown in Figure 2 of the patent drawing; that when the side wall moved outwardly, as the tire was inflated, it would snugly hug the tire; that, normally, the side wall

had an almost perpendicular shape curving inwardly toward the end of the side wall in the direction where the tire would be; that, after the side wall was installed, and the tire initially expanded, the side wall would be pressed outwardly; and when the tire was fully expanded, the side wall would hug the tire at all times. The foregoing amendment, Nickerson added therein, "quite clearly defines applicant's invention, and is solely within the confines of the original disclosure and description." The above corresponds, in different language, to Nickerson's claims now before the court.

After the filing of this amended application, the Patent Office again rejected claims 4 to 9 inclusive, as being unpatentable over the prior art, specified as the Spencer and Daniel patents.

In response to a further amendment, filed by Nickerson on December 29, 1952, the Patent Office again rejected claims 6 to 9 inclusive, on August 19, 1953.[2]

Subsequent to the foregoing rejection, the File Wrapper discloses the following statement by Nickerson:

> "As a result of a careful review of the entire record of this case, and as the result of an interview courteously granted by the Examiner in charge of this application on March 23, 1954, it has been deemed advisable to cancel all claims in this case, and in lieu

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[2] The rejection of the Patent Office filed August 19, 1953, states:

"Claims 6 to 9, inclusive, are also rejected, if believed to be a valid combination, as being unpatentable over Spencer in view of Daniel and for the reasons fully set forth in Office action of December 16, 1952.

"Claims 6 to 9 inclusive, are further rejected on Spencer in view of Barnes. To make the ornamental side wall of Spencer in a single piece, as taught by Barnes, would not involve invention. The provision of an annular cut-out and the specific shape of the lip do not involve invention since these are merely matters of design.

* * * * *

"Figure 2 of Spencer shows the wheel rim 11, pneumatic tire 16, tube 17, and side wall 5. While this side wall is made up of three sections, there would be no invention in making it in a single piece especially in view of the teaching of Barnes. In an old combination rejection it is not necessary to show all the details of any element of the combination such as the lip and cut-out for example. However, the several features claimed are shown by the references. Fig. 2 of Spencer shows the lip at 13 and Fig. 3 of Barnes shows the tapered portion which bears against the side wall of the tire. Spencer also shows the lip between the rim flange and the tire so that when the tire is inflated the lip and side wall will be held in place."

thereof add new claims 12 and 13 to the record of this case.

"At the above named interview, the Examiner agreed to allow new claims 12 and 13, since the features recited in these claims are not shown nor suggested by the references made of record, whether taken alone or together."

These new claims, 12 and 13, submitted on March 23, 1954, were allowed as claims 1 and 2—and the only claims—of the original patent, issued on October 12, 1954, on the ground that "the features recited in these new claims were not shown or suggested by the references made of record, whether taken alone or together."

The features in claims 12 and 13, which were allowed as claims 1 and 2 of the patent originally issued, were allowed because they were not shown in the prior Spencer, Daniels and Barnes patents. These features, which were not shown in the prior patents, and because of which the Nickerson original patent was allowed, are, it appears to be agreed, the following:

> An annular cut-out, defining a hump where the greatest thickness occurs, together with an intermediate flat portion between the lip and the outer portion of the side wall.

In other words, the features upon which the patent was granted were the cut-out, hump, and the flat portion.

This Nickerson patent with its two claims was finally issued as heretofore stated on October 12, 1954. Claim 1 of the patent finally issued, after describing the annular cut-out, the hump, and the intermediate flat portion, concluded with the phrase, "said side wall being biased outwardly and frictionally embracing the tire when the tire is inflated."

There would be no invention in a side wall "being biased outwardly," inasmuch as Barnes had already described his side wall as having "its inner peripheral portion turned inwardly for engagement and support intermediate said tire casing and said rim."

See ante page 8.

In the beginning of July, 1954, Barnes brought his original aluminum mold for the making of said walls to Bearfoot. The mold was in two parts. The combination of the two aluminum parts, joined together, produced a side wall; and a specimen side wall produced out of this mold had substantially the same appearance and cross section as the accused Bearfoot side wall shown on one of the charts introduced into evidence as an exhibit.

Furthermore, examination of the Barnes mold disclosed that it was designed to make a side wall having its outer edge tipped or inclined towards the tire, as compared with the lip of the side wall. There was no indication, in the Barnes molds, that any metal parts or other resilient means were to be inserted in the molds, and there was no provision for inserting such resilient springs. Furthermore, the indication was to the contrary. It would have been impossible to maintain any springs, at any particular place in the mold, while manufacturing the side wall, or to prevent the flow of rubber from displacing them, if such springs had, in any way, been used. Bearfoot never attempted to use springs in making the Barnes side wall, or any of the side walls mentioned, or introduced into evidence, in the case. As stated by Bearfoot, the rubber of the side walls is itself sufficiently resilient "for urging the [side wall] into abutting and embracing relation with respect to said outer side wall of said tire casing," in the language of the Barnes' patent.

On October 1, 1956, almost two years after Bearfoot began manufacturing the side walls in question, Nickerson filed his application for a reissue patent. In his oath accompanying his application for the reissue patent, Nickerson stated that he believed "his original patent to be invalid in that it claimed less than he was entitled to; that claim 1 contains the following phrases that were included in the claim, not by necessity, but negligent drafting, said phrases being: provided with a central circular opening, the outer peripheral edge of said side wall being of reduced thickness, said side wall having an intermediate flat portion between the lip and outer portion, said lip including a flat portion and an arcuate portion, said cutout defining a hump providing a vertex for the outer portion of the side wall, said wall having its greatest thickness at the hump; . . . that he verily believes himself to be entitled to the following claims:

"Claim 3, An elastic detachable side wall for pneumatic tires comprising, in combination, an annular body portion, a recessed inner portion connected to inside edge of body portion and adapted to fit between rim flange and adjacent portion of tire, said body portion and said inner portion acting in conjunction as an elastic unit are subject to a shearing force when the tube is inflated immediately endowing body portion with potential energy of distortion exerting a force equal to and in an opposite direction to shearing force causing said body portion to snugly engage tire.

"Claim 4, An elastic detachable side wall for pneumatic tires comprising, in combination, a means for utilitarianly ornamentally covering side wall portion of pneumatic tire, and a means for anchoring said covering means along its inside edge, said covering means and said anchoring means acting in conjunction as an elastic unit are subject to a shearing force when the tube is inflated immediately endowing covering means with potential energy of distortion exerting a force equal to and in an opposite direction to shearing force causing said covering means to snugly engage tire."

On November 5, 1956, the Patent Office rejected both claim 3 and claim 4. In the rejection the Patent Office stated that these claims call for an elastic unit subject to "a shearing force," but do not state where the shearing force takes place. The Patent Office further rejected both claims on the ground of new matter; that there was no mention in the specification of the original application of any shearing force; that claims 3 and 4 were both broad claims, which corresponded to claim 3 in the original application, and that the functional statements did not define any structural differences to distinguish these claims from claim 3 of the original application; that claim 3 of the original application was cancelled by an amendment, and therefore constituted a bar to claims 3 and 4 in the reissue application, "because it is well settled that the deliberate withdrawal of a claim in order to obtain a patent does [not] involve inadvertence or error and is not a mistake of the kind which will justify the reissue of the patent including the matter previously withdrawn." Claims 3 and

4 were further rejected as being unpatentable over the Spencer & Barnes patents.[4]

In this vast flood of words in which the Patent Office repeatedly found, year after year, that different phrasing of alleged new claims merely represented the same thing as prior claims that had already been rejected, it may be helpful to remember one essential fact. Many of Nickerson's claims and amended claims, in the proceedings to secure the reissue patent, were rejected on the ground that they corresponded to claims 3 and 4 in the original application; both of which had been rejected, cancelled, and deliberately withdrawn, and would therefore not justify a reissue patent including matter previously withdrawn. These claims, 3 and 4 of Nickerson's original application, were those claiming a side wall "curved inwardly." Nickerson's claims 3 and 4 in his application for the reissue used different terms than a side wall "curved inwardly," to describe what the Patent Office found had already been described in the rejected claims of Nickerson's original application, although he phrased the matter in these words:

> "An elastic . . . side wall . . . . comprising, in combination, an annular body portion, a recessed inner portion connected to inside edge of body portion, and adapted to fit between rim flange and adjacent portion of tire, said body portion and said inner portion acting in conjunction as an elastic unit are subject to a shearing force, when the tube is inflated immediately endowing body portion with potential energy by distortion exerting a force equal to and in an opposite direction to shearing force : . . causing said body portion to snugly engage tire."

While this claim was rejected by the Patent Office as being indefinite, it was also rejected because it corresponded in scope to previously cancelled claim 3 in the original

[4] The Patent Office declared: "The Claims [3 and 4 of the reissue] broadly recite a side wall for a vehicle having an annular body portion and a recessed inner portion adapted to fit between rim flange and the adjacent portion of the tire. Spencer and Barnes both show detachable side wall for pneumatic tires comprising an annular body portion devised to overlie the side wall of the tire and an inner lip portion devised to rest between the tire retaining flange of the rim and the tire bead portion. There would be no invention involved to provide a recess or cut-out in the inner portion of the Barnes or Spencer side wall as claimed."

application, except for functional statement recited therein, and because such functional statement "does not define any structural differences to distinguish these claims from the cancelled claim 3 of applicant's original invention." We conclude, then, that claims 3 and 4 of the reissue, with their terminology of "shearing force," "endowing body portion with potential energy of distortion," "and exerting a force equal to and in an opposite direction forcing body portion to snugly engage tire," mean no more than that the elastic, resilient material, of which the side wall was made, was "curved inwardly," and that when the tire, against which the side wall was curved, was inflated, it would press against the side wall.

In reply to the rejection of claims 3 and 4 of the reissue application, Nickerson amended his application on February 11, 1957, to insert the following claims:

"5. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim and rim flanges, comprising an annular body portion *adapted to be inoperatively positioned axially inwardly of its operating position*, a recessed lip portion connected to the inside edge of the body portion and adapted to fit between the rim flange and adjacent portion of the tire, the body portion *and the lip portion coact to cause the body portion to engage the inflated tire*, the side wall is constructed of a flexible material.

"6. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim and rim flanges, comprising, an annular body portion *adapted to be inoperatively positioned axially inwardly of its operating position*, an anchoring means connected to the inside edge of the body portion and adapted to anchor the inside edge of the body portion in a position at the junction of the outside surface of the side wall of the tire casing and the rim flange, *the body portion and the anchoring means coact to cause the body portion to engage the inflated tire*, the side wall is constructed of a flexible material.

"7. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a

vehicle wheel having a rim and radial rim flanges, comprising, an annual body portion, an inner portion connected to the inside edge of the body portion and having a recessed portion and a lip portion, the recessed portion is adapted to rest on the axially arcuate portion of the radial rim flange and the lip portion is adapted to rest between the radial rim flange and adjacent tire portion, *the inner edge of the lip portion terminates at a point radially within the limits of the radial rim flange, the inner portion and the body portion coact to cause the body portion to engage the inflated tire,* the side wall is constructed of a single piece of flexible material.

"8. An ornamental side wall for attachment between a vehicle tire casing and rim, comprising, an annular body portion of flexible material, the outer peripheral edge of *said annular body portion being inwardly curved*, the inner portion of said body portion being recessed and defining a lip for insertion between said tire casing and rim, said lip being anchored between said inflated tire casing and rim, and said recessed portion of said annular body portion providing a hump which is maintained in firm contact with the mating portion of said rim when said lip is anchored between said inflated tire and said rim, whereby said body portion is caused to snugly embrace the outer surface of said inflated tire casing." (Emphasis supplied.)

To this amendment, Nickerson added the following under the term "Remarks":

"Regarding the Examiner's rejection stating that the recess is a matter of design, and to say that the lip in my invention would function in the same manner as Barnes', is a misunderstanding of both the invention and the prior art.

"*By cross-sectionally shaping the side wall as I have*, by dividing it into sections at the locations set forth in the claims, by providing a recessed lip as I have and not a single continuous curved section, are the reasons why my side wall can accomplish what heretofore was not possible.

"To be more specific, in the Spencer patent the main body of the side wall is, in cross-section, designed in one piece and there is no distinctively set forth two parts (sic), namely a body portion and a recessed lip portion as I have. Rather the Spencer side wall is described as a reversedly curved or sinuous in cross-section, as found in line 61 of column 1, with the concave portion fitting between the clincher ~~of the~~ rim and the tire, lines 63 and 64 of column 1. This is a very definite structural difference between Spencer's side wall and mine, only one of the reasons why, if Spencer's side wall were constructed of a flexible material instead of rigid, it would not function as mine.

* * * * *

"Also the Barnes' side wall is described in cross-section as arcuately shaped to conform to the outside wall of the tire casing, as found in lines 1 to 5, column 2. The main body is defined as one continuous flow through the radial flange to the point where it connects with the skirt. In my side wall the body portion ends where it connects with the recessed portion and there is quite a difference structurally and operatively. Also, because my lip terminates at a point where Barnes' body portion joins his skirt portion, the method for anchoring the side wall is different."

On March 13, 1957, the Patent Office rejected all of these claims in the following language:

"Claims 5, 6, 7 and 8 are rejected on the ground that failure to obtain these claims in the original application was not due to inadvertence or error, for the reasons as stated in the last office action. These claims are similar in scope to cancelled claim 3 of the original application, and, as stated the deliberate withdrawal of a claim in order to obtain a patent does not involve inadvertence or error which will justify the reissue of a patent."

The Patent Office, therefore, considered the phrase in the rejected claims, "an annular body portion adapted to be inoperatively positioned axially inwardly of its operating position," and which Nickerson stated he had shaped

"cross-sectionally," to be nothing more than phraseology representing the scope of cancelled claim 3 of the original application, which stated that the side wall was "curved inwardly."

The above is especially pertinent since, on the hearing, the principal expert witness introduced on behalf of Nickerson, Dr. Paul L. Hoover, testified: "[That] was the big contribution of Nickerson to this art, the fact that you could, by designing and proportioning your sidewall member make it hug the tire by having this distortion present, molding it so that in its unstressed condition it was different from the stressed condition, and the inherent resilience and internal stress of the element necessarily would hold it in place without the necessity of springs or other auxiliary means. That was Nickerson's big contribution."

If this particular phase of the case were before us for consideration without the guidance of the above-mentioned rejection of the Patent Office, it might well be difficult to determine whether claims 5 to 8 inclusive of the reissue were similar in scope to cancelled claim 3 of the original application. Certainly, Nickerson advanced an emphatic claim that his invention consisted of his shaping the side wall cross-sectionally, to make "an annular body portion adapted to be inoperatively positioned axially inwardly of its operating position," and Dr. Hoover's testimony strongly supported this claim. But the claim was clearly rejected as similar in scope to cancelled claim 3 of the original application which had been thereafter withdrawn, and as the Examiner stated: "The deliberate withdrawal of a claim in order to obtain a patent does not involve inadvertence or error which will justify reissue of a patent." Thus, Dr. Hoover's testimony on the trial appears to have been in support of the patentability of a claim that (in slightly different phrasing) had already been rejected.

Here, let us consider rejected claim 5, which was subsequently cancelled by appellee, with claim 3 of the reissue, as far as the phraseology relating to the side wall goes. Rejected claim 5 related to a side wall "comprising an annular body portion adapted to be inoperatively positioned axially inwardly of its operating position . . .. the body portion and the lip portion coact to cause the body portion

to engage the inflated tire." Compare the foregoing phraseology to that of claim 3 of the reissue as finally allowed, of a side wall "having an annular body portion . . . the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion, . . . the body portion and lip portion coacting to cause the side wall to engage the inflated tire. . . ." All of this phraseology, while, in our view, of needless complexity, does not require the assistance of expert witnesses to enable the court to understand it; and we find that the foregoing phraseology of claim 3 does not convert the phraseology of rejected claim 5 into anything having patentable quality.

Dr. Hoover is a recognized expert in patent cases, and this court, on other occasions in the past, has found considerable assistance in the views he has expressed in various cases. However, his testimony going to the patentability of Nickerson's claim was a conclusion, the ascertainment of which was the obligation of the court; and the use of expert testimony in a patent case is only to help the court understand what the specifications say. When the expert witness has done this, his function is fulfilled. As said by Judge Learned Hand in *Kohn* v. *Eimer*, 265 Fed. 900, 902 (C.C.A. 2):

> "At the outset the appellant challenges our right to examine the prior art patents at all, because the appellee called no expert at the trial to explain them. . . . We have not the slightest wish to minimize the vital importance of expert testimony in patent suits, or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility

of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence."

In this connection, we should observe, however, that the testimony of Dr. Hoover, which has often in the past proved of help, is never, for this court, "a burdensome impertinence."

After the rejection of claims 5, 6, 7, and 8, the flood of phraseology continued in Nickerson's amendment of June

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The claims Nickerson asked to insert in lieu of the cancelled claims 5, 6, 7 and 8 were as follows:

"9. An ornamental side wall for attachment between a vehicle tire casing, and rim comprising, an annular body portion of flexible material, the outer peripheral edge of said annular body portion being inwardly curved, the inner portion of said body portion being recessed and defining a lip for insertion between said tire casing and rim, said lip provides a means for anchoring said side wall between said inflated tire casing and rim, and said recessed portion of said annular body portion providing a hump which is maintained in firm contact with the mating portion of said rim when said lip is anchored between said inflated and said rim whereby said body portion is caused to snugly embrace the outer surface of said inflated tire casing.

"10. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim including rim flanges, comprising, an annular body portion having a central circular opening, . . . the outer peripheral edge of said body portion being curved inwardly, an arcuately recessed lip portion connected to the inside edge of the body portion and adapted to fit between the rim flange and the adjacent portion of the tire, the body portion and the recessed lip portion coacting to cause the body portion to engage the inflated tire, the side wall is constructed of a single piece of elastic material.

"11. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim including rim flanges, comprising, an annular body portion in cross-section having an outer peripheral edge of reduced thickness and curved inwardly, . . . an arcuately recessed lip portion connected to the inside edge of the body portion and adapted to fit between the rim flange and adjacent portion of the tire, the body portion and the recessed lip portion coact to cause the body portion to engage the inflated tire, the side wall is constructed of a single piece of elastic material.

"12. A unitary ornamental side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim including rim flanges, comprising, an annular body portion having a central circular opening, said body portion in cross-section having an outer peripheral edge of reduced thickness and curved inwardly, . . . an arcuately recessed lip portion connected to the inside edge of the body portion and adapted to fit between the rim flange and adjacent portion of the tire, the body portion and the recessed lip portion coact to cause the body portion to engage the inflated tire, the side wall is constructed of a single piece of elastic material.

10, 1957, in which he asked the Patent Office to cancel these claims, and insert claims 9, 10, 11, 12, and 13 in lieu thereof.[5]

On July 17, 1957, the Patent Office rejected claims 9, 10, 11, 12 and 13 for the same reasons given in rejecting claims 5, 6, 7 and 8, and expressly found that the newly rejected claims defined a structure identical to rejected claim 3 of the original application, describing a side wall "curved inwardly."[6]

On September 26, 1957, Nickerson renumbered claims 8 to 12 inclusive, so that they would appear as claims 9 to 13 inclusive. He then cancelled claim 9 and amended

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"13. A side wall adapted to be detachably mounted on a pneumatic tire mounted on a vehicle wheel having a rim including rim flanges, comprising, . . . an inner portion connected to the inside edge of the body portion, said inner portion having an arcuate recess portion and a lip portion, the recess portion is adapted to rest on the axially arcuate portion of the rim flange and the lip portion is adapted to rest between the rim flange and adjacent tire portion, the inner edge of the lip portion terminates at a point radially within the limits of the rim flange, the inner portion and the body portion coacting to cause the body portion to engage the inflated tire, the side wall is constructed of a single piece of elastic material."

[6] In rejecting claims 9 to 13, inclusive, the Patent Office stated:

"To the extent that these claims define structure they appear to be identical to claim 3 which was cancelled from the original application. This recited structure consists of an ornamental annular side wall of a single piece of flexible material the outer edge being of reduced thickness and curved inwardly and an annular cut out arranged around the inner peripheral edge of the side wall to define a lip for insertion between the rim flange and tire casing. This structure is found in both cancelled claim 3 in the original case and claims 9-13 of the instant case. The latter group of claims contain functional limitations relating to the contact between the side wall and tire, such as appears in claims 9 and 10 or to the initial placement of the side wall, as shown in Figure 4, and recited in claims 11-13. Such limitations relate to nothing more than the inherent operation of applicants structure and are therefore of no different scope than claim 3 which was cancelled from the original case.

"Claims 1 and 2 stand allowed.

"As no new references have been added and an issue appears to have been reached this rejection is made final.

"FINAL REJECTION."

[7] Nickerson's amendment of claims stated:

"In claim 10, substitute for the phrase—said body portion in cross-section is adapted to be inoperatively positioned axially inwardly of its operating position—with the phrase—said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position of the body portion.

"In claims 11 and 12, substitute for the phrase—said body portion is adapted to be inoperatively positioned axially inwardly of its operating position—with the phrase—said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position of the body portion.

claims 10, 11, 12 and 13 by certain substitution of phrasing.

Thereafter, claims 10 to 13 inclusive were finally rejected by the Examiner "on the ground that failure to obtain these claims in the original application was not due to inadvertence or error. These claims are held to be similar in scope to cancelled claim 3 in the original application. It is well settled that the deliberate withdrawal of a claim in order to obtain a patent does not involve inadvertence or error and is not a mistake of the kind which will justify the reissue of the patent including the matter previously withdrawn.".

In this rejection, it was determined that the new phraseology, "said body having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position of the body portion" was equivalent, in scope, to the phraseology "an annular body portion adapted to be inoperatively positioned axially inwardly of its operating

"In claim 13, substitute for the phrase—an annular body portion in cross-section adapted to be inoperatively positioned axially inwardly of its operating position—with the phrase—an annular body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position of said body portion."

Under the heading of "Remarks" Nickerson added:

"The phrase, in its improved form and generally stated: 'said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position,' is the very essence of the invention because it gives patentable life to the claims. This spark of patentable life is completely missing from cancelled claim 3. In short, the remaining claims state that I have invented a detachable side wall of a single piece of elastic material, having a cross-sectional shape, that by this shape alone, and with no auxiliary means such as ribs (Barnes), or a rigid construction (Spencer), will snugly engage the inflated tire. This is because the cross-sectional shape of the side wall places the body portion on a plane that is axially inwardly of its operating position, which, when put into operation, produces a state of distortion in the body portion. The body portion being of an elastic material will strive to correct this distortion, and in doing so will exert a force to snugly engage the inflated tire.

"The body portion doesn't necessarily have to be biased inwardly when not in operation, for that matter it can be biased outwardly when inoperative as long as it must be distorted axially outwardly from its original position by the inflated tire.

"In referring to the allowed claim 1 of the issued patent, you will notice that it includes the phrase: 'said cut-out defining a hump providing a vertex for the outer portion of the side wall.' This is the qualifying phrase, the patentable difference between allowed claim 1 and all references cited. This is also true regarding cancelled claim 3. Claim 1 was allowed because it defined a shape that took advantage of the elastic properties of the material. Allowed claim 1 was good in that respect, but that particular form was a narrow way of claiming the invention."

position," and that the phraseology in both of the above instances was equivalent in scope to cancelled claim 3 of the original application.

With regard to the phraseology used, we are of the view that the above rejection is of special importance in this case because of the claim made by Nickerson that: "The phrase, in its improved form and generally stated: 'said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position,' is the very essence of the invention because it gives patentable life to the claims. This spark of patentable life is completely missing from cancelled claim 3."

This alleged "essence" of the invention was not recorded by Nickerson until his final amendment of his reissue patent of September 26, 1957. A French patent, published April 12, 1954, showed, in cross section, a side wall mounted with its lip between the rim flange and the adjacent portion of the tire; and the French patent stated that the rubber side wall "can advantageously have, when at rest, the curve shown in dotted lines on the drawing," so that, when mounted, its outer edge "will be pressed with a certain amount of elastic pressure against the side of the tire." The curve mentioned was shown by the dotted lines as an inwardly curved position. The drawings of the French patent showed that the side wall was axially inwardly of the distorted operational position. The "essence" of the invention, which was first claimed by Nickerson in 1957, was revealed in the French patent published in 1954. It is to be noted that the language used by Nickerson in his final amendment of September 26, 1957, is substantially similar to that used in a patent, 2,737,422, issued to Barnes on March 6, 1956, in which the specifications stated: "Provision of the desired resiliency and compressive forces within the trim member . . . is insured in this particular embodiment of the invention by making the outer peripheral edge of the annular body . . . generally define a plane positioned axially inwardly of the entire skirt portion . . . of the trim member and in all events to have such edge of the trim member define a plane axially inwardly of the trim member with relation to the connection between the annular body . . . and the skirt."

After the rejection of claims 10 to 13 inclusive by the Examiner, the rejection was affirmed by the Board of Appeals. The ground on which the Examiner rejected these

claims, as appears above, was that the failure to obtain these claims in the original application was not due to inadvertence or error, and that they were similar in scope to claim 3 of the original application which had been cancelled.

The ground on which the Board of Appeals affirmed the rejection of claims 10 to 13 inclusive was somewhat different from that given by the Examiner. The Board held that claims 10 to 13 inclusive were subcombination claims, directed to the same subcombination as claim 3, which had been cancelled in the original patent proceedings, and that the cancellation of claim 3, under the circumstances, was not a correctible error.

Nickerson thereafter petitioned for reconsideration, cancelling claims 11 to 13 inclusive, and amending the application by rewriting claim 10, and renumbering such rewritten claim as claim 14. On reissue, the Board held, that, because its ground of rejection of claims 10 to 13 inclusive was a new rejection and, because it had not agreed with the reasons given by the Examiner in refusing this subcombination claim, that the decision of the Examiner should be reversed, so that the case could be reopened before the Examiner "for treatment of amended claim

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* The Board's decision sustaining the rejection of the Examiner and affirming his decision, on different grounds, was as follows:

> "We have considered this case including the arguments presented by appellant and the file of the patent and find that the following are the facts. The application on which the original patent issued was filed containing claims both to the combination of wheel rim, tire and side wall, which combination is exemplified by the above quoted patent claim 1, and a claim to a subcombination directed to the side wall element per se, i.e., the same subcombination covered by above quoted application claim 10. The single claim to the subcombination was cancelled by the first amendment, leaving only combination claims. By the second amendment claims to the subcombination were reintroduced and thereafter claims to combination and subcombination were prosecuted to final rejection. In the patent file Paper No. 10D is an amendment introduced after final rejection that cancelled all claims in the case and added two claims, namely, the present patent claims. The remarks accompanying such amendment state that the amendment was filed pursuant to an interview, at which interview the examiner agreed to allow the two combination claims.
>
> "The preceding makes clear that the cancellation of the claims to the side wall per se was a deliberate act following final rejection and an interview at which the examiner agreed to allow the two combination claims that became the patent claims. Such a deliberate act is not a correctible error and thus we will sustain the rejection.
>
> "The decision of the examiner is affirmed."

14." When the case came again before the Examiner, he allowed claim 14 after a minor change in phrasing; and claim 14 became the present claim 3 of the reissue patent.

Appellee claims that the Board's decision on reconsideration, was based upon the ground that the Board had previously been mistaken in thinking that Nickerson was seeking allowance of reissue claims, which were broader than the original claims. Appellee contends that when it was shown that Nickerson's reissue claim had a narrower scope than cancelled claim 3 of the original patent application, the Board granted reconsideration to reopen the case before the Examiner "for treatment of amended claim 14."

Appellants, on the other hand, contend that while claim 3 in the original application (which was rejected), was a subcombination claim relating only to the side wall itself, and that the new amended claim 14 (which was eventually allowed), was a combination claim, relating to the side wall, *and* the wheel rim having annular flanges as well as the tire casing and tube, nevertheless, this combination had already been rejected in the rejection of claim 4 of the original application, which claimed:

> "4. In combination, a wheel rim including a web and a pair of annular flanges projecting from said web, a pneumatic tire casing mounted on said rim, a tube arranged in said casing, an ornamental annular side wall fabricated of a single piece of flexible material and provided with a central circular opening, the outer peripheral edge of said side wall being of reduced thickness and curved inwardly, there being an annular cutout arranged around the inner peripheral edge of said side wall to define a lip for insertion between the tire casing and rim flange."

We are of the view that combination claim 14 of the reissue (claim 3 of the reissue as ultimately allowed) was a combination claim directed to the same combination as rejected claim 4 of the original application, which had been cancelled six years previously and therefore could not be made the basis of a claim in the reissue patent.

It is of interest to note certain contentions of appellee in this regard. Nickerson, in his oath petitioning for the

reissue patent says, "he believes his original patent to be invalid in that it claimed *less* than he was entitled to," and then sets forth what he did think he was entitled to. Nickerson's counsel, in their brief on appeal, state that in his reissue claim 3, Nickerson was seeking the allowance of a claim having a scope *narrower* than cancelled claim 3 of the original application. In his testimony on the trial, Nickerson said that "Claim 1 (of the original patent) was *narrow*—it specified a specific shape—and in claim 3 it was corrected. That error was corrected in stating that *any* structure that was distorted outwardly would fall within the scope of the patent." (Emphasis supplied.) In his remarks accompanying his amendment of the reissue, dated September 26, 1957, Nickerson stated: "Claim 1 was allowed because it took advantage of the elastic properties of the material. Allowed claim 1 was good in that respect, but that particular form was a *narrow* way of claiming the invention." (Emphasis supplied.)

The foregoing would indicate that Nickerson, instead of narrowing his claim in the reissue application, as his counsel contend in their brief, was phrasing it in a way to broaden it. But the record is too filled with vague verbiage on this point to draw a valid conclusion; and, in our determination, we find it unnecessary to decide whether Nickerson was claiming more or less in his reissue than in his original application.

What does concern us is whether the phraseology used by Nickerson in claim 14 of his reissue application (claim 3 as allowed) constituted a claim which, as he contends, defined his invention and which, appellee submits, appellants appropriated and infringed. This phraseology of the claim goes to the so-called "principle of resiliency," which appellee says is the essence of his invention, as described in claim 3 of the reissue:

> "the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion."

We, then, consider, in extenso, the language of claim 3 of the reissue: "said side wall having a central circular opening and a peripheral edge of reduced thickness that is curved inwardly, the body portion having an unstressed cross-sectional shape defining a plane that is axially in-

wardly of the operating position of said body portion . . ., the body portion and the lip portion coact to cause the side wal' to engage the inflated tire."

This phraseology is equivalent to the phraseology in the rejected amended claims 10 to 13 inclusive of the reissue—"said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position . . . the body portion and the recessed lip portion coacting to cause the body portion to engage the inflated tire;" it is likewise equivalent to the phraseology in the rejected claims 10 to 13 inclusive, before amendment—"the outer peripheral edge of said body portion being curved inwardly, an arcuately recessed lip portion connected to the inside edge of the body portion and adapted to fit between the rim flange and the adjacent portion of the tire, the body portion and the recessed lip portion coacting to cause the body portion to engage the inflated tire." It is likewise equivalent to the phraseology of rejected claim 5 of the reissue—"an annular body portion adapted to be inoperatively positioned axially inwardly of its operating position . . . the body portion and the lip portion coact to cause the body portion to engage the inflated tire." It is likewise equivalent to the phraseology of rejected claims 3 and 4 of the reissue—"said body portion and said inner portion acting in conjunction as an elastic unit are subject to a shearing force when the tube is inflated immediately endowing body portion with potential energy of distortion exerting a force equal to and in an opposite direction to shearing force causing said body portion to snugly engage tire." This phraseology is also equivalent to that used in rejected claim 3 of the original application: a "side wall fabricated of a single piece of flexible material . . ., the outer peripheral edge of said side wall being of reduced thickness, and curved inwardly." Furthermore, all of the above phraseology is equivalent to that contained in claim 1 of the original patent: a "side wall. . . . the outer peripheral edge of said side wall being of reduced thickness . . ., said side wall being biased outwardly and frictionally embracing the tire when the tire is inflated." It is to be emphasized that whether the Examiner was right or wrong in rejecting any of the above claims, it is not for the court to inquire. *Hubbell* v. *United States*, 179 U. S. 77, 83; and when once a claim is rejected, and cancelled or withdrawn, another claim, covering what had

been rejected and withdrawn, cannot be granted. The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. *Schriber Co.* v. *Cleveland Trust Company*, 311 U. S. 211, 221.

4 — In addition, and more important; all of the above phraseology in both Nickerson's rejected and approved claims in the original application and the reissue, is equivalent to the language of Barnes, in his patent, antedating Nickerson: "A trim member for attachment to an automobile wheel assembly . . . said trim member being fabricated of rubber and comprising an annular body disposed in confronting relation with respect to the outer side wall of said tire casing, said annular body having its inner peripheral portion turned inwardly for engagement and support intermediate said tire casing and said rim."

All of the foregoing means, in the simplest terms, that a rubber side wall elastic and resilient in itself, and made with an inward bend, will hug the tire when the latter is inflated, since its own resistance holds it against an inflated tire.

Although Nickerson had declared in his amendment of September 26, 1957, that the phraseology " 'said body portion having a cross-sectional shape defining a plane that is axially inwardly of the distorted operational position,' is the very essence of the invention because it gives patentable life to the claims," and further declared, that "This spark of patentable life is completely missing from cancelled claim 3," it appears nowhere that the Examiner or the Board of Appeals of the Patent Office ever considered this so-called essence of Nickerson's invention patentable. Nowhere does it appear that this phraseology or any of the phraseology in the various claims, quoted or reviewed in the foregoing paragraphs, were considered by the Patent Office as embracing any patentable claims; and, although claims 1 and 2 of the original application contained the phraseology as to the side wall being biased outwardly, and claim 3 of the reissue contained complicated phraseology as to the side wall being curved inwardly, and "the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion," the Patent Office repeatedly rejected the claims that this and similar phraseology partook of

any patentable quality, in spite of appellee's insistence on this very point.

At no time during the many different rulings of the Examiner and the Board of Appeals, reciting reasons for granting or rejecting the numerous claims of appellee, was there any mention of anything from which it could be inferred that they considered any of the phraseology as to the shape of the side wall, being axially inwardly of the distorted operational position, or the side wall being biased outwardly, or curved inwardly, as elements partaking of patentable invention.[2]

The original patent and the reissue must have been and were, granted because of entirely different features than anything defined in the foregoing phraseology. For the claims of a patent must be interpreted with respect to cancelled or rejected claims, and an allowed claim may not be read to cover what has been eliminated from the patent. *Miller* v. *Zaharias*, 72 F. Supp. 29; aff. 168 F. 2d 1; cert. den. 335 U. S. 823.

As heretofore mentioned, claims 1 and 2 were granted because of the cut-out, the hump, and the flat portion set forth therein. When, in considering the question of patentability, the complicated phraseology relating to the shape of the side wall is held for naught, as we have determined it must be, claim 3 of the reissue is, in our view, a combination, directed to the same combination as rejected claim 4 of the original application.

With regard to claims 1 and 2 above mentioned, Nickerson, on cross examination, claimed that a flat surface could be a curved surface; and that he considered a surface having an arc as flat, if it was smooth. This is not persuasive in establishing that one of the features of Nickerson's side wall giving rise to invention was a specified "flat portion." As for the hump, which was relied upon by Nickerson to prevent a reverse fold-back of the side wall,

[2] It is pertinent to emphasize the origin of the descriptive language claimed by appellee, on September 26, 1957, to be the essence of his invention—"*the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position.*" This language, as heretofore mentioned, comes directly from Barnes' third patent filed December 19, 1955, and issued March 16, 1956, eighteen months before Nickerson had first, and finally, stated that his revised language was what gave "patentable life to the claims." The language in Barnes' third patent sets forth that his side wall "*as molded...generally defines a plane positioned axially inwardly* of the [side wall]."

Dr. Hoover, Nickerson's expert witness, testified that "we actually make the side wall thicker at the point . . . where the fold-back would normally occur." The fold-back was illustrated by cutting a hollow thin rubber ball in half and showing how one of the halves would be turned inside out, or folded back, by pressing it against a large circular shape. It is obvious that in order to keep a thin rubber side wall from folding back it should be made of thicker rubber. That is what Dr. Hoover testified was done by Nickerson—"We reinforce it there by increasing the thickness." That does not partake of invention.

As to Nickerson's patent, a "cut-out" means, in the language of Nickerson's expert witness, Dr. Hoover, that "material is either removed or makes the appearance of being removed, and it makes the wall thinner by that cut-out." In the drawings of Nickerson's patent, the thick wedge of rubber side wall appears cut out at its lower portion, as though it were pared away by a knife, and as a result of the cut-out, the inner and lower part of the side wall becomes the lip inserted between the rim and the tire. Using the term "cut-out" as interpreted by Dr. Hoover, it is impossible to find in appellants' thin curving side wall, any cut-out, as so defined. But, for the purpose of this case, we accept appellee's contention that the accused side walls have the hump of greatest thickness, the cut-out, and the flat portion, that are found in appellee's side wall.

Appellee's patent is a paper patent. No model of it was ever made. Appellee never made a side wall according to his original patent or reissue. He tried to make one but, as he said, his mold did not make a true side wall. After using molds and failing to make an operable side wall in accordance with the claims of his original patent, he gave up trying; and never attempted to make a side wall in accordance with the reissue patent.

Appellee filed his complaint September 24, 1958. In answer to appellee's complaint, appellants pleaded that appellee's patent and every claim thereof was invalid and void as directed to inoperable structures. Nearly two years elapsed after appellants' answer was filed before trial, but appellee, confronted with the claim that his side wall was inoperable, never tried to show by an actual side wall made according to his patent, that it was operable. Dr. Hoover, appellee's expert witness, was asked whether he

had ever made a Nickerson side wall. His reply was "No." To the question whether he had tried to make a Nickerson side wall, his answer was: "No, not particularly. We considered having one made but I'll say we got started a little late." In view of the defense that a side wall made in accordance with Nickerson's patent was inoperable, and in view of the fact that the only time appellee ever tried to make a side wall in accordance with his patent, it was a failure and he could not make a true side wall—and neither he nor his expert witness ever tried again to make a side wall in accordance with his patent—the presumption that the patent is operable disappears.

The fact that Bearfoot may have constructed its side walls as taught by its licensor, Barnes, omitting, however, the springs, specified by Barnes for "urging the side wall into abutting and embracing relation" with respect to the tire casing, does not make it an infringer of Nickerson, whose patent omitted the springs. In rejecting claims 6 to 9 inclusive of Nickerson's original application, the Examiner referred to the Barnes patent and declared that Barnes showed the tapered portion which bore against the side wall of the tire; and in the final rejection of claims 9 to 13 inclusive, of the reissue, the Examiner mentioned the limitations Nickerson had placed in the claims relating to the contact between the side wall and the tire, or to the initial placement of the side wall, and held that such limitations related to nothing more than the inherent operation of appellee's structure and, therefore, were of no different scope than claim 3 which had been held unpatentable, and which had been withdrawn. 16

Rubber is not a completely unknown and mysterious substance. Children know it in numerous forms, from bouncing balls and elastic rubber bands to resilient bicycle and automobile tires. It is obvious to anyone that if a flat sheet of resilient rubber is bent out of its molded shape, it will press against the bending force and fly back to its original flat form when the pressure is released. So, it is obvious to anyone that if resilient rubber is molded in a curved form, it will likewise press against anything that pushes it out of such curved form. It would be obvious to anyone skilled in the art that a resilient rubber side wall curved inwardly and having a lip inserted between the rim flange and adjacent portion of a tire would press

against the tire and, if formed in the requisite shape, would engage the tire. Whether the side wall is described as disposed in confronting relation with respect to the outer side wall of the tire casing and having its inner peripheral portion turned inwardly for engagement and support intermediate the tire casing and rim, as stated by Barnes; or whether the side wall was described as biased outwardly and frictionally embracing the tire, when the tire was inflated, as stated by Nickerson; or whether the side wall had an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said side wall, as was also described by Nickerson—we are of the view that not any of the phraseology defining such inward, or outward, or unstressed cross-sectional shape, of the side wall, resulted in any patentable quality or invention. Nickerson testified that the phrase, "the body portion having an unstressed cross-sectional shape defining a plane that is axially inwardly of the operating position of said body portion," was "just a technical way of saying that any side wall that has a cross-sectional shape that has to be distorted by the inflated tire falls within the scope of the claim." What Nickerson did was to give his side wall an inward bend which an inflated tire would push against. This was old in the art. Barnes had done the same thing before Nickerson; and Bearfoot, whether it followed the Barnes' patent or not, did the same thing before Nickerson. If the inward bend of the Barnes side wall were exaggerated by Nickerson, the side wall would cling more tightly to an inflated tire; but the construction of such an exaggerated inward bend for such an objective would be obvious.

The only persons who attempted to produce before the trial court a side wall made according to Nickerson's patent were appellants, who submitted an exhibit which comprised a wheel having a Sieberling modern tire mounted thereon, together with what appellants declared was a simulated Nickerson side wall, made by them from molds they constructed, and mounted between the flanges of the wheel and the Sieberling tire. Appellants also produced and submitted to the court a cross section of this simulated Nickerson side wall. Although appellee did not attempt to produce and submit a side wall or even a section thereof, his expert witness and counsel denigrate, in every way, the side wall and the section of the side wall which appellants

submit they made according to Nickerson's patent. In effect, appellee's counsel charge appellants with deception in producing a Nickerson side wall and cross section which, as already observed, neither Nickerson nor Dr. Hoover attempted to produce, and which Nickerson admitted he had tried to make and failed. Counsel for appellee claimed, in fact, that appellants selected the Sieberling tire solely to show that the Nickerson side wall would not work. They also insisted that the cross section of the side wall which appellants made to illustrate Nickerson's patent was not proportional to the side wall shown in Nickerson's patent. Much of the testimony on this point, as it appears in the transcript, is largely unintelligible and where a gleam of meaning shows through, the witnesses are largely in dispute.

In any event, in this contention, one of the controlling factors of the case quietly emerges. Appellee claims that it was wrong of appellants to use a Sieberling tire to show how the Nickerson side wall worked. In this regard, appellee's expert witness testified that when Nickerson applied for a patent in 1951, the standard car tire "was a 6.00 x 16 high pressure tire. This Sieberling is a 14 x 8.00, is entirely different in proportion, it is a low pressure tire, balloon type of tire; and you will notice the bead is altogether different." In their brief, appellee's counsel say: "It is unmistakably clear that defendants selected the Sieberling tire with the pronounced lug, for the very purpose of preventing the side wall from hugging the inflated tire." It was appellants' claim that a side wall made according to Nickerson's patent would be pressed outward by an inflated tire so that the outer edge of the side wall, instead of engaging or pressing against the tire, would flare outwardly, leaving a space between the side wall and the tire; and that this result was due to the fact that the rounded tire, as it was inflated, would push against the lower flat portion of Nickerson's side wall and press the side wall away, leaving the outer edge flaring away from the tire. When the side wall made by appellants, following what they claimed was Nickerson's patent, was used on an inflated Sieberling tire and showed the outer edge of the side wall flaring away from the tire, appellee attacked the demonstration on the ground that the low pressure Sieberling tire with the pronounced lug was selected, for the

very purpose of preventing the side wall from hugging the inflated tire. However, appellants' own side wall worked perfectly with the Sieberling tire; and when the Nickerson side wall, made by appellants, was mounted on an inflated Goodrich Silvertown tire and rim without any so-called lug on the tire, the side wall gapped away from the Goodrich tire in the same way as it did from the Sieberling tire. Appellant's side walls operated perfectly on both Sieberling and Goodrich tires. It appears that appellants make the same type of side wall for each size of rim diameter. Every one of their side walls, made for a certain rim diameter, accommodates all tires of every kind, high pressure or low pressure, with or without lugs, that fit that rim. In other words, appellants' side walls operate successfully no matter what kind of tire is used. Counsel for appellee admits that a Sieberling tire, for instance, because of its pronounced lug, prevents appellee's side wall from hugging the inflated tire, or, in brief, from operating successfully on all tires.

Why do appellants' side walls actually operate successfully on all sizes and shapes of tires, and why does appellee's side wall fail to operate on all sizes and shapes of tire, as is admitted by appellee's counsel? The simple answer to these questions results in one of the controlling determinations in this case—there is no substantial identity between appellee's side wall and appellants' side wall.

In order to infringe a patent, a device or machine must not only perform the same, or susbtantially the same, function or accomplish the same result as the patented invention, but it must also perform the function or accomplish the result by identical, or substantially identical, or equivalent means. Conversely, a machine or device which performs the same function or accomplishes the same result by substantially different means, or by a substantially different principle or mode of operation, or in a substantially different way, does not infringe the patented invention. *Swan Carburetor Co.* v. *Chrysler Corp.*, 130 F. 2d 391 (C.C.A. 6); *Flowers* v. *Austin-Western Co.*, 149 F. 2d 955 (C.C.A. 7); *Montgomery Ward & Co.* v. *Clair*, 123 F. 2d 878 (C.C.A. 8); *Wheat* v. *Ford Motor Co.*, 118 F. 2d 612 (C.C.A. 8); *Holtzer-Cabot Electric Co.* v. *Standard Electric Time Co.*, 111 F. 2d 71 (C.C.A. 1); *Shakespeare Co.* v. *Perrine Mfg. Co.*, 91 F. 2d 199 (C.C.A. 8).

In resolving the question whether there is identity of method, means, and mode of operation between the Bearfoot side wall and the Nickerson side wall, it is necessary to compare their operation.

The Bearfoot side wall has a lip. The lip is that part of the side wall which is squeezed and held between the rim flange and the tire casing. At the top of the lip, the side wall continues to extend, but is spaced away from the tire casing by a "lateral connecting bridge" of said side wall. This lateral bridge, after being spaced away from the tire casing, turns almost at a right angle to the connecting bridge and continues its extension, facing the tire, but spaced away from it. This extension curves inwardly toward the tire casing, the top of the side wall being tipped toward the tire and contacting the tire when the latter is inflated. The Bearfoot side wall is kept away from the lower part of the tire, or, in other words, there is a space between the side wall and the lower part of the tire. When the tire is inflated, the base of the side wall, immediately above the rim, continued to be spaced away from the tire wall, but the top part of the side wall, curving and tipped inwardly, contacts the middle or upper part of the tire wall. The fact that there is a space between the side wall and the tire wall immediately above the rim accounts for the fact that the Bearfoot side wall operates successfully whether the tire wall has a pronounced lug on it, or whether it is a low pressure, balloon type of tire, or a high pressure tire similar to those that were generally used in earlier years. The circumstance that the tire may have a pronounced lug on it, or is a low pressure, balloon type, has no effect on the operation of the Bearfoot side wall, the reason being that as the tire is inflated, it does not come in contact with the side wall except where it is tipped inwardly at the middle or upper part of the tire, and consequently does not press the side wall away, leaving the outer edge flaring from the tire.

Strangely enough, the lateral bridge and the spacing of the side wall away from the tire, immediately above the rim, do not appear to be a part of Barnes' teaching. This device seems to be something developed by Bearfoot; and it is to be noted that appellants in their brief stated:

"The Bearfoot side walls departed sharply from the teachings of Nickerson by incorporating the lateral

connecting bridge to space the base of the side wall away from the tire immediately above the rim, and thereby assure contact between the tire and the outer portion of the side wall."

Whatever the origin of the Bearfoot accused side walls, they are operable, where Nickerson's are not; and they do not function as Nickerson claims his side wall functions.

The fact that a tire may have a pronounced lug on it, or is a low pressure balloon type, does have an effect on the operation of a side wall made in accordance with Nickerson's patent, and results in such side wall being inoperable, under these circumstances.

The reason why the Nickerson side wall is inoperable under the foregoing circumstances is because the low pressure balloon type of tire with the pronounced lug, when inflated, presses against the lower part of Nickerson's side wall, just above the rim, and pushing against the lower part of the side wall, causes it to lean away from the tire. This fact is clear from the undisputed testimony, and the admission of appellee's counsel that the Nickerson side wall would not successfully operate with a low pressure tire having a pronounced lug. Appellants claim that Nickerson's side wall would be inoperable with any tires, high pressure or low pressure, for the same reason that it would not be operable with low pressure tires having a pronounced lug. The evidence supporting this contention is persuasive; but we do not decide this case on the ground that Nickerson's patent is inoperable. In this regard, we leave the presumption of operability untouched, and do not interfere with the trial court's findings on this phase of the case.

But we are clearly of the view that the Bearfoot side wall as appears from the foregoing, because of its lateral bridge, resulting in the side wall being spaced away from the tire immediately above the rim, and assuring contact between the outer part of the side wall and the tire, accomplishes its result by a substantially different principle, means, and mode of operation, and in a substantially different way than Nickerson, and hence, does not in any way infringe the Nickerson patent.

It is to be remarked that the expert witnesses for each side differed completely on practically all of the facts of

the case, even in describing the simplest objects before them. Appellee's witness declared that the Bearfoot side wall had the hump, cut-out, and flat portion which Nickerson had claimed as the patentable features of his side wall. The expert witnesses for Bearfoot absolutely denied that Bearfoot had a hump, cut-out, and flat portion. The Bearfoot side wall was in evidence, and was used in their testimony, as recited above, by the experts for both sides. Measurements were computed in thousandths of an inch, and such circumstances easily enables one expert to define differences, in contradicting opposing witnesses. The Nickerson side wall does not resemble the Bearfoot side wall in appearance.

The cross section of the Nickerson side wall appears as a long rather thick wedge of rubber turned inwardly toward the tire, with a lip at its lower inner end. The cross section of the Bearfoot side wall appears as a comparatively thin piece of rubber shaped like a sickle, the lip appearing where the handle of the sickle would be. The fact that testimony, introduced in behalf of appellee, was to the effect that the Bearfoot side wall had a flat portion, a cut-out, and a hump of greatest thickness as found in Nickerson, and that the court found that the Bearfoot side walls contained all these features and therefore infringed Nickerson's patent, is not controlling.

"An abundance of authority sustains the point that a defendant's device may be within the language of a claim and not be an infringement; that an infringement is not a mere matter of words. *General Electric Co.* v. *Allis-Chalmers Co.*, 178 F. 273, 276 (C.C.A. 3); *General Electric Co.* v. *Allis-Chalmers Co.*, 171 F. 666, 669, citing *Westinghouse* v. *Boyden*, 170 U. S. 537." *Henderson* v. *Welch Dry Kiln Co.*, 26 F. 2d 810, 814.

"We note that appellant contends that the claims of the patent in suit read upon appellees' device. We may assume that this is true. . . . But infringement is not a mere matter of words. *Henderson* v. *Welch Dry Kiln Co.*, D. C., 26 F. 2d 810, 814; *Goodyear Shoe Mach. Co.* v. *Spaulding*, C. C., 101 F. 990, 994; *Linde Air Products Co.* v. *Morse Dry Dock & Repair Co.*, 2 Cir., 246 F. 834, 838; *Bird* v. *Elaborated Roofing Co. of Buffalo*, 2 Cir., 256 F. 366, 373. Here, we hold that the mode of operation is different and that there is no equivalency of means." *Grant* v. *Koppl*, 99 F. 2d 106, 110 (C.C.A. 9).

"Appellant cites, as evidence of infringement, the testimony of his expert witness, George J. Henry, to the effect that some of the claims in suit read upon appellee's machine. This, appellant contends, was sufficient to require submission of the case to the jury. The contention is rejected. Infringement is not a mere matter of words. *Grant* v. *Koppl*, 9 Cir., 99 F. 2d, 106, 110. The evidence shows conclusively that, properly construed, the claims in suit were not infringed by appellee. That being so, it is immaterial—if true—that some of the claims read upon appellee's machine." *McRoskey* v. *Braun Mattress Co.*, 107 F. 2d 143, 147 (C.C.A. 9).

"Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant's device. Two things are not necessarily similar in a practical sense because the same words are applicable to each. The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative, as well as qualitative." *Goodyear Shoe Mach. Co.* v. *Spaulding*, 101 Fed. 990, 994.

"There is no magic in a name, nor in a claim; that the words preferred by a patentee to define his invention apply literally to another's device suggests, but does not prove infringement; there must be a substantial identity, to justify that conclusion of law. *Edison* v. *American Co.*, 151 Fed. 787." *Linde Air Products Co.* v. *Morse Dry Dock & Repair Co.*, 246 Fed. 834, 838 (C.C.A. 2).

proved merely by reading a claim upon an accused device. Nor infringement is not

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Accepting appellee's contention that appellants' side wall reads upon the side wall of appellee; that, in appellants' side wall, there is a hump of greatest thickness; a cut-out; a flat portion; and that appellants' side wall is within the language of appellee's claim, nevertheless, there is no infringement by appellants, for the mode of operation of their side wall is different, and there is no equivalency of means.

Since we have concluded that there is no substantial identity of mode of operation between the Bearfoot side wall and the Nickerson side wall, the findings that Bearfoot has the flat portion, the cut-out, and the hump of greatest thickness, found in Nickerson, are not of consequence.

It is contended by appellee that a demonstration of the claimed Nickerson side wall, made in court, by appellants,

was invalid, unfair, and deceptive, because the lip of the side wall in question was foreshortened by ¼ inch—contrary to the lip disclosed in the Nickerson patent—creating a hidden vacancy between the inner periphery of the lip and the bead seat, and caused the side wall to gap away from the tire. However, a similar demonstration was made with the same side wall bolted in place so that there could be no hidden vacancy, and the side wall gapped away from the tire in the same way. While this is not of transcendent importance, in the decision of the case, it deprives of force appellee's contention that the experiment was deliberately deceptive.

"The grant of a patent is presumptive evidence of its validity and the finding of the District Judge as to a fact is entitled to great weight. But when the full facts as to what constitutes the invention are, as here, undisputed, it remains at last, for this court, giving due regard to the weight to be given to the grant of the patent and the finding of invention by the District Judge, to examine the record for itself and to determine whether, within the meaning of the statute conferring patent monopoly, there is invention and therefore patentability. The presumption of patentability which attends the grant of a patent cannot survive in the face of undisputed facts showing that there is no invention." *Butex Gas Co.* v. *Southern Steel Co.*, 5 Cir., 123 F. 2d 954, 955.

In accordance with the foregoing, it is our conclusion that the patent claims sued upon are invalid for want of invention, and, furthermore, that, if they were valid, appellants are not chargeable with infringement, since there is no identity of mode of operation between the side wall of appellee's patent and appellants' accused side walls.

The determination of other issues raised is unnecessary to decision.

The judgment is therefore reversed, and the case remanded for entry of a judgment in compliance with this opinion.

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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. 146

BRYAN W. NICKERSON, JR.,
Petitioner,

v.

THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,
Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR CERTIORARI.

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In the Supreme Court of the United States

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No. 1117.

BRYAN W. NICKERSON, JR.,

Petitioner,

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THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,

Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR CERTIORARI.

STATEMENT.

(1) No conflict of lower Court decisions and no constitutional issue are involved in this case. There are no "special and important reasons" for review by this Cour as set forth in Supreme Court Rule 19. The only apparer reason presented by petitioner *pro se* for granting certiorari is that in deciding against him the Court of Appeals erred because it did not understand the "real truth" and "did not act with propriety"; and that failure to grant certiorari would be to "knowingly compromise judicial integrity" and endanger the whole patent system. If such a reason were to be held adequate for certiorari, all unsuccessful litigants would be encouraged to take their cases *pro se* to the Supreme Court on the ground that the Court below did not understand the true facts of the case.

"The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower

court decisions." (Address of Chief Justice Vinson before American Bar Association, Sept. 7, 1949.)

Seldom has the record and Patent Office history of a patent been more carefully reviewed and thoroughly analyzed by a Court in an effort to understand the true facts than was done in the exhaustive unanimous decision by the Sixth Circuit Court of Appeals in this case.

The petitioner, in filing this petition *pro se* and emphasizing his low income, is following a pattern similar to that which he used in the Patent Office to obtain his Reissue Patent No. 24,518, now held invalid by the Court of Appeals for the Sixth Circuit.

In the Patent Office, petitioner employed attorneys who obtained his original patent for an attachable white sidewall for automobile tires, but when respondent's sidewall appeared on the market shortly thereafter, petitioner filed application *pro se* for reissue, claiming that the original patent claims were the result of "negligent drafting" on the part of his attorneys. (App. p. 85a.)*

In this litigation, petitioner employed attorneys to represent him in the District Court and Court of Appeals, and when his Reissue Patent was held invalid he filed this petition *pro se*, stressing the fact that he is of low income and the father of four.

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* Refers to appendix of appellant in Court of Appeals.

STATUTES INVOLVED.

In citing Title 35 U. S. Code, Sections 251 and 114, petitioner has omitted Title 35 U. S. Code, Section 103, as follows:

> "§ 103. Conditions for patentability; non-obvious subject matter.
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

That this statute is involved is clear from the Court of Appeals decision (Dec. page 31),* as follows:

> "Rubber is not a completely unknown and mysterious substance. Children know it in numerous forms, from bouncing balls and elastic rubber bands to resilient bicycle and automobile tires. It is *obvious*** to anyone that if a flat sheet of resilient rubber is bent out of its molded shape, it will press against the bending force and fly back to its original flat form when the pressure is released. So, it is *obvious* to anyone that if resilient rubber is molded in a curved form, it will likewise press against anything that pushes it out of such curved form. It would be *obvious* to anyone skilled in the art that a resilient rubber side wall curved inwardly and having a lip inserted between the rim flange and adjacent portion of a tire would press against the tire and, if formed in the requisite shape, would engage the tire."

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* Refers to decision of Sixth Circuit Court of Appeals.

** Emphasis supplied in all quotations.

QUESTIONS PRESENTED.

Questions 1 and 3 present no questions of law. Question 1 asks, in effect, if it is proper for a Court of Appeals to decide a case contrary to "the truth" in the record as interpreted by the unsuccessful litigant. Question 3 asks if a Court can use words of a Patent Office Examiner, who was reversed by the Board of Appeals, to support the Court's conclusions in deciding against the petitioner.

Question 2 attempts to inject a question of law by implying that the Court of Appeals decision holds that the subject of a patent must be tested for operability to be patentable.

ARGUMENT.

Question 2.

Referring first to Question 2, petitioner himself says (Pet. page 8):

> "The District Court and Circuit Court found the structure operative. Operativeness is not an issue here"

What the Court of Appeals said was:

> "Appellants claim that Nickerson's side wall would be inoperable with any tires, high pressure or low pressure, for the same reason that it would not be operable with low pressure tires having a pronounced lug. The evidence supporting this contention is persuasive; but *we do not decide this case on the ground that Nickerson's patent is inoperable*. In this regard, we leave the presumption of operability untouched, and do not interfere with the trial court's findings on this phase of the case."

Actually, petitioner is posing Question 2 for the obvious purpose of enlisting the sympathy of the Supreme Court for an individual who is unable financially to spend

huge sum of money to test and develop his invention. By petitioner's own admission, this situation is not an issue here.

Petitioner says the Court of Appeals decision "infers" that an inventor who does not actually produce and test his invention for operativeness does not have a valid patent, and that if a Court invalidates a patent because it is an inoperative paper patent, then the U. S. government has encouraged the inventor to disclose his invention "under false pretenses."

The Patent Office granted petitioner his patent without any requirement of petitioner to test his invention for operability, and the Court of Appeals did not question the propriety of such grant. It was only after petitioner sued respondent that the issue of inoperability was raised by respondent. Petitioner was able to hire counsel and a well-known patent expert to try the case, but made no attempt at the trial to demonstrate that respondent's claim of inoperability was invalid. The Court of Appeals said (Dec. pp. 30, 31):

> "Nearly two years elapsed after appellants' answer was filed before trial, but appellee, confronted with the claim that his side wall was inoperable, never tried to show by an actual side wall made according to his patent, that it was operable. Dr. Hoover, appellee's expert witness, was asked whether he had ever made a Nickerson side wall. His reply was 'No.' To the question whether he had tried to make a Nickerson side wall, his answer was: 'No, not particularly. We considered having one made but I'll say we got started a little late.' In view of the defense that a side wall made in accordance with Nickerson's patent was inoperable, and in view of the fact that the only time appellee ever tried to make a side wall in accordance with his patent, it was a failure and he could not make

a true side wall—and neither he nor his expert witness ever tried again to make a side wall in accordance with his patent—the *presumption that the patent is operable disappears.*"

Apparently, petitioner would rewrite the Patent Laws to provide that once a patent is granted by the Patent Office, no Court has the right to question operability of the invention, or to hold a patent valid for inoperability even if so proven, contrary to the established case law.

Walker on Patents, Deller's Ed., page 313, states the rule as follows:

"Utility is absent from all processes and devices which cannot be used to perform their specific functions, and patents for such subjects are therefore void." (Citing authorities.)

And on page 314:

"In *Bliss v. Brooklyn*, 10 Blatchf. 521, 522, Fed. Case No. 1546 (1873), the patent covered a certain hose-coupling. The contrivance was worthless, because it was proved *on trial* to be inoperative."

According to the syllabus in *H. Brinton Co. v. Mishcon*, 93 F. 2d 445 (C. A. 2—1937):

"A device to be patentable must be useful, and to be useful it must work. (35 U. S. C. A. §31)."

Question 1.

Petitioner's discussion of facts re Question 1 admits that an erroneous decision *per se* does not warrant review by the Supreme Court, and then argues for about 15 pages that the decision of the Court of Appeals is erroneous because it is wanting in accuracy and truth. What petitioner construes as the truth is the opposite of the Court's findings in its decision.

It would seem unnecessary to burden this Court with a detailed refutation of petitioner's claimed errors allegedly committed by the Court of Appeals. The Court's decision fully answers all of these allegations. For example, petitioner says (Pet. p. 7) that the invention was accomplished by departing substantially from the teachings of the prior art. The Court of Appeals said (Dec. p. 32):

> "What Nickerson did was to give his side wall an inward bend which an inflated tire would push against. This was old in the art. Barnes had done the same thing before Nickerson; and Bearfoot, whether it followed the Barnes' patent or not, did the same thing before Nickerson."

Petitioner says (Pet. p. 8) that:

> "The initial pre-distorted, cross-sectional shape of the side wall is in fact the invention."

After extensive review of the patent file wrapper, the Court of Appeals held (Dec. pp. 28, 29):

> "All of the foregoing means, in the simplest terms, that a rubber side wall elastic and resilient in itself, and made with an inward bend, will hug the tire when the latter is inflated, since its own resistance holds it against an inflated tire." * * *
>
> "At no time during the many different rulings of the Examiner and the Board of Appeals, reciting

reasons for granting or rejecting the numerous claims of appellee, was there any mention of anything from which it could be inferred that they considered any of the phraseology as to the shape of the side wall, being axially inwardly of the distorted operational position, or the side wall being biased outwardly, or curved inwardly, as elements partaking of patentable invention.

"The original patent and the reissue must have been and were, granted because of entirely different features than anything defined in the foregoing phraseology. For the claims of a patent must be interpreted with respect to cancelled or rejected claims, and an allowed claim may not be read to cover what has been eliminated from the patent. *Miller v. Zaharias*, 72 F. Supp. 29; aff. 168 F. 2d 1; cert. den. 335 U. S. 823."

Petitioner's Statement of Facts is nothing more than a repetitious argument countering alleged errors in the Court of Appeals' decision by self-serving statements of "The truth" as petitioner sees it. The Court of Appeals went over all this ground with a fine-toothed comb, and concluded not only that the patent was invalid for want of invention, but even if valid, it was not infringed by respondent (Dec. p. 39).

Of the twelve alleged errors, possibly Error 2 needs clarification because of the petitioner's complete misunderstanding of Patent Law. According to petitioner Error 2 was the Court's contention or inference that activity by respondents prior to the issuance of petitioner's patent somehow invalidates the patent.

What the Court said was (Dec. p. 12):

"On October 1, 1956, almost two years after Bearfoot began manufacturing the side walls in question, Nickerson filed his application for a reissue patent."

Obviously, the Court had in mind the Reissue Statute, Title 35 U. S. Code, Section 252, which reads in part:

> "No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent."

Petitioner's reference to interference proceedings in the Patent Office is wholly irrelevant, since neither his reissue nor his original patent were ever involved in any interference proceedings.

Question 3.

Apparently, petitioner is complaining because the Court of Appeals agreed with certain statements made by the Examiner in the Patent Office, even though he was reversed by the Patent Office Board of Appeals. This is tantamount to a contention that the Supreme Court in this case could not agree with the decision of the District Court because it was reversed by the Court of Appeals, which is precisely what the petitioner is asking the Supreme Court to do.

Question 3 is specious on its face.

Petitioner implies that the Board of Appeals reversed the Examiner and allowed the reissue application. Actually, the Board of Appeals first affirmed the Examiner and on reconsideration reversed his rejection, but since it reversed on new grounds, it remanded the case to the Examiner who subsequently allowed the application with a single new claim not involved in the original appeal.

Petitioner's so-called "Reasons For Granting The Writ of Certiorari" are nothing more than an argumentative criticism of the Court of Appeals because its decision was, in the petitioner's opinion, "an extremely unbelievable, erroneous decision."

The inconsistency of petitioner's argument is readily apparent from the following two statements from his petition:

> "It took almost a year to hand down the decision which numbered thirty-nine pages, and the Circuit Court commented extensively on the file wrapper, etc. It would appear indeed that the Circuit Court had done a very thorough job." (p. 22)
>
> "The Circuit Court, relying on the arguments of counsel, without self-determination from the record, reversed the Trial Court." (p. 23)

To accuse the Court of Appeals of applying a practice which provides "fertile ground for corruption and the whole patent system is in danger," and to imply that allowing the Court's decision to stand would be "to knowingly compromise judicial integrity," are very serious charges even for a disgruntled individual who sought to litigate his patent in the Federal Courts.

Respondents are small corporations who, after taking a license and paying royalties in good faith under the Barnes patents, were sued without prior notice for infringement of petitioner's paper patent, and thus subjected to the expense and harassment of litigation jeopardizing the continuance of their business. Petitioner has had his full day in Court, and, after an extensive review of the merits of the case, the Court of Appeals below has ruled against him *on the facts*.

CONCLUSION.

The petition does not present any questions requiring resolution by this Court, and should be denied.

Respectfully submitted,

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Office-Supreme Court, U.S.
FILED
AUG 14 1963

IN THE

Supreme Court of the United States

OCTOBER TERM 1963.

No. 146

BRYAN W. NICKERSON, JR.,

Petitioner,

vs.

THE BEARFOOT SOLE CO., INC.
THE BEARFOOT AIRWAY CORP.,

Respondents.

REPLY TO RESPONDENTS' BRIEF OPPOSING CERTIORARI

BRYAN W. NICKERSON, JR.
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IN THE

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REPLY TO RESPONDENTS' BRIEF OPPOSING CERTIORARI

STATEMENT

Petitioner regrets that Counsel for Respondents has *continued* to argue this case in the manner of that used in the lower court for now it becomes necessary to be unethically blunt in briefing the Supreme Court on his style of writing. Counsel was probably motivated by the fact that his efforts were rewarding in the Circuit Court, but Petitioner feels secure in the knowledge that the Supreme Court will not abide this approach to arguing a case.

Petitioner is referring to Counsel's practice of delusion in lieu of objectivity in his arguments. Delusion is a harsh word, yet what else would define the practice of subtle and deliberate clouding the issues and obscuring the truth?

It appears to Petitioner, not used to reading legal briefs, that Counsel does not have an argument, therefore must create one, and a misleading style of writing is the result.

The present brief, opposing certiorari, may be viewed as an abridged example of Counsel's past style of delusion, and is replete with the type of argument Petitioner is referring to.

The following are notations on some, but are by no means all of the misleading statements, for nearly every page and paragraph contain some to a degree.

IN DIRECT REPLY TO BRIEF OPPOSING CERTIORARI

In the Statement

The Supreme Court is concerned with the *manner* in which lower courts reach an incorrect decision.

Petitioner never mentioned low income in prosecuting reissue application in the Patent Office. Reissue was obtained on the merits alone. Petitioner stands on the merits of this present case and is neither seeking nor wants preferential considerations due to low income.

Court is respectfully referred to application for extension of time—included therein is an affidavit stating that Petitioner's counsel in lower courts was retained on a contingent basis.

In Questions Presented

The majority of errors pointed out in the petition were really inaccuracies, the errors of which are fully supported by the documents and facts of record. Few of these errors were in the grey area where opinion might enter to affect broad or narrow conclusions. Therefore, contrary to Counsel's remarks, the errors cannot be interpreted to favor any party—only the truth.

In Question 2

As set forth in remarks on Question 2 of the petition, Petitioner is not questioning right of courts to question oper-

ativeness of patent. It is the Circuit Court's clear inference that production of invention by patentee as a requirement for validity, thereby conflicting with the statutes, equity, and realism, that Petitioner questions the wisdom of.

Counsel's attempt to tie in the operativeness issue with production by patentee, argued on pages 4, 5 and 6 of brief opposing certiorari, is typical of style of delusion in which Counsel for Respondents is astute.

In Question 1

Following are pertinent comments in reference to Error 2 of petition, and specifically the discrepancy in dates of first day of production of Port-A-Wall. In addition, comments in reference to Counsel's statements on page 8 of brief opposing certiorari.

That a conflict of dates exist is without question. (See petition, page 11.) This discrepancy, only recently discovered through perseverance by Petitioner, was found buried in the file wrapper of one of Barne's numerous patents.

Although having indications of a fictitious story, *e.g.*, different dates from two different sources nearly always means a fabrication, one is inclined to give the Respondents the benefit of the doubt for it was possible that a straightforward reason existed for the discrepancy. Respondents had a chance to come forward with this reason in the brief opposing certiorari. This they did not do. Rather Counsel resorted to delusion—and thereby lies the clue—for in reacting thusly they unknowingly and unretrievably revealed their true deceptive position regarding the discrepancy.

This delusion takes the following form.

Counsel's remarks on page 8 of brief opposing certiorari as related to Error 2 is an attempt to distract from real reason for establishing an early date of production of Port-A-Wall. His real reason was to establish obviousness of the invention in the Circuit Court, and this he did as follows:

Included in the record on appeal to Circuit Court was a Chronology (Appendix 135A) which was reproduced in Appellants' brief and referred to by Counsel. This chronology chart alone is ambiguous. (compare dates with scale)

Counsel also included in record, and briefed thereon, four pages of testimony by Mr. Taylor, (Appendix 32A thru 35A) an employee of Respondents. Counsel also said in brief to Circuit Court:

> "Bearfoot designed and ordered production molds before the original Nickerson Patent No. 2,691,550 issued October 12, 1954, with two claims."
>
> "Bearfoot began manufacture and sale of their side walls November 2, 1954. . . ."

Early intentions of counsel were clearly to convince Circuit Court that Respondents did not rely on teachings of patent, implying, thereby, that side wall was obvious.

Now in brief opposing certiorari Counsel states (page 9) that Circuit Court regarded these activities in relation to intervening rights under the reissue Sec. 252. Intervening rights, as set forth therein, would be extraneous matter to the Circuit Court who had found the patent invalid and not infringed.

In view of foregoing, Counsel has confirmed fabrication of production date by trying to distort true reason for establishing date in the first place. It would seem that Respondents lost their right to fair consideration from the moment they entered this false evidence. If not then, surely it was when they tried to distort its significance.

In Question 3

The analogy drawn by Counsel that the Court of Appeals agreeing with the Examiner is the same as the Supreme Court agreeing with the District Court is suggesting a situation that requires a circumstantial vacuum to be valid. But where in life do we find such a vacuum.

As *standard* Patent Office procedure, Board of Appeals *always* remands the case back to the Examiner, but in effect the Board does the allowing.

In reference to last paragraph of brief opposing certiorari, Respondents were given ample pretrial opportunity to settle this case reasonably.

Further, according to Poor's Register, the Bearfoot Sole Co. Inc., employs approximately five hundred and fifty

persons. The Bearfoot Sole and Bearfoot Airway Corp. are each rated as having assets in excess of one million dollars by the Thomas Register. (amounts over this sum not specified) Although not huge by some standards, this is hardly the picture Counsel paints of the Respondents.

It is also an odd twist of semantics to call the act of a patentee seeking relief from an infringer harassment.

ARGUMENT

In view of the foregoing, then, the Counsel for the Respondents has shown with his own hand how misleading his style of arguing this case has been. He has emphasized, thereby, the necessity for self-determination in the Courts, for without it there can be no truth and without truth there can be no justice. As long as there are lawyers who, lacking an objective case to argue, will resort to delusion, self-determination by the Courts is a prerequisite function.

It is entirely realistic at this point to suggest that Counsel's style of arguing was a major contributing factor in the Circuit Court's inaccuracies. Further proof that self-determination was lacking may be found also in the frequency with which Circuit Court *relied* on determinations of Patent Office Examiner. Circuit Court had been misled by Counsel to believe that Board of Appeals had concurred with the Examiner.

Supreme Court must look to the future in deciding issues of today. As social and technological questions become more complex, fallible judges *could* rely on *prima facie* truth. But this is obviously not the answer for attorneys and experts are not neutral. Rather, the Supreme Court in its wisdom, Petitioner feels, will choose the harder way, *i.e.*, direct that self-determination be maintained as an uncompromising method of deciding cases, thereby compelling the *best of minds* to exert great effort until there is a limit even to their human abilities. Then, and only then, *and by that road*, will the *right* solution rise up to solve the problem of adjudging the extremely complex issues of the future. Reviewing this inaccurate decision of the Circuit Court would serve notice on the community of law that the

practice of delusive arguing of a case is not favored by the courts, that *prima facie* truth is not controlling and self-determination will prevail.

This, of course, applies to factual issues, not opinions that may vary according to preconceived ideas.

CONCLUSION

For many reasons, some of which are set forth here, it is not in the best interest to the judiciary or the citizenry for *prima facie* truth to become a fixture of the judicial process.

Courts have the sympathy of the citizens in deciding complex issues but they also have their trust. Maintaining, in the judiciary, the worthiness of their trust is the best gift the Supreme Court can give the American people.

Respectfully submitted.

BRYAN W. NICKERSON, JR.

Petitioner

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IN THE

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PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

BRYAN W. NICKERSON, JR.
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IN THE

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THE BEARFOOT AIRWAY CORP.,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

Petitioner prays that this Court grant rehearing of its order of October 14, 1963, denying petition for writ of certiorari, and that a writ of certiorari issue to review the judgment of the Court of Appeals of the Sixth Circuit in the above entitled case as prayed for in the petition filed May 21, 1963, herein.

STATEMENT

If your Petitioner is being presumptuous in thinking that the Supreme Court would want to review this case, he prays that he has not also taxed the Court's patience by being persistent.

Tact is desirable, indeed necessary, in all dealings between men, but sometimes the point can become lost in tactfulness.

Petitioner is, therefore, restating the point, perhaps less tactfully, but to the best of his ability. And, it should be added, with complete respect for the Court of Appeals for the Sixth Circuit.

The point is that there is something *profoundly wrong* with the decision of the Circuit Court. Petitioner failed, persuasively, to make this point in the petition for certiorari, for once the Supreme Court becomes cognizant of this fact it would know that herein involved is a matter so intrinsic to functional jurisprudence, and when manifested in a decision, so adverse to truth and justice, that it is frightening. For when a court accepts arguments of counsel at their face value and disregards the real truth as found in the record which is contra to that argument, justice becomes a pawn of clever lawyers. The implications of deciding cases in this manner are chaotic.

The sign of justice is the traditional scale symbolizing the weighing of facts. These facts are obtained from arguments of counsel and considered in the light of the record. Adapting arguments that do not find support in the documents, exhibits, and facts of record, could make a mockery out of truth and justice.

By their creation, the circuit courts are speaking for the Supreme Court. Would the Supreme Court readily accept arguments of counsel, *per se*, without confirming them in the records? — of course not.

Without knowing the cause, the effect is indisputably clear: the Circuit Court accepted and unqualifyingly adopted, at face value, the arguments of the counsel for the Defendants. The Circuit Court disregarded the truth as contained in the record in the form of documents, exhibits, etc.

That the above claim is applicable to the present opinion is discussed at length but less obtrusively in errors 1 thru 12, Pages 9 to 19, of the petition for certiorari, and they are to supplement this present petition. But now there is an absolute means of proof not so vulnerable to mis-interpretation. This new proof is so deceptively simple that your Petitioner, after reviewing the opinion with a fine tooth comb, missed it at first. It seemed to come in a sense of

retrospection and was confirmed in the basement of the Supreme Court building upon inspection of Defendant's side walls mounted on tires and wheels.

This proof deals with the question of infringement and establishes the grave claim of your Petitioner that the Circuit Court has violated section 5, among others, of the Canons of Judicial Ethics. Canon 5 states in part: "... and diligent in endeavoring to ascertain the facts." What is more, the Circuit Court has violated an American's semantically bred sense of right and wrong.

To escape the responsibility of infringement, the Defendants created a myth relative to the major function of their side wall. This myth, called a lateral connecting bridge, was not fully exploited at the trial, and with good cause, for as it turned out the trial judge saw through their entire fabricated case and found the patent valid and infringed.

It was a different story in the appeal, however, for this myth became full blown, and the counsel for the Defendants stressed this lateral brige as a departure from the Petitioner's patent in suit as a new means for keeping the side wall inwardly towards the tire. The myth was stressed in the brief to the Circuit Court to the extent of being forcibly restated on six different pages of that brief. This is probably best summed up in these words:

> "The Bearfoot side walls departed sharply from the teachings of Nickerson by incorporating the lateral connecting bridge to space the base of the side wall away from the tire immediately above the rim, and thereby assure contact between the tire and the outer portion of the side wall.
>
> "The Bearfoot side walls do not have the same or equivalent method, means and mode of operation as does the Nickerson side wall."

This myth was completely and unquestionably accepted by the Circuit Court echoing in two separate places the language of the Defendant's counsel. The Circuit Court said: (Decision, Page 36, Key 20)

> "But we are clearly of the view that the Bearfoot side wall as appears from the foregoing, because of its

lateral bridge, resulting in the side wall being spaced away from the tire immediately above the rim, and assuring contact between the outer part of the side wall and the tire, accomplishes its result by a substantially different principle, means, and mode of operation, and in a substantially different way, than Nickerson, and hence, does not in any way infringe the Nickerson Patent."

Proof and the point of the fact to which Petitioner is directing the Supreme Court's attention lies in the basement of the Supreme Court building in the form of five of Defendant's side walls.

Petitioner begs the Court's indulgence to the degree of checking these exhibits for they are the keystone to this present petition.

Keeping in mind the nature of the bridge as defined in the words of the Circuit Court and illustrated in Appendix 122a (bottom), an examination of the side walls reveals no lateral bridge except in part in an area of two of the side walls where it is obvious that the side wall is not assembled properly, or has been squeezed out of position by the action of the tire and rim. And therein lies the subtleness of the error, for there is just enough of a bridge in part of two of the side walls to *superficially justify* adaptation of the bridge myth. The majority of the side walls show no bridge, especially in the early models disproving the mythical bridge theory completely. The bridge would have to be present in all the side walls, particularly in the early models, and function as the major means of keeping the side wall towards the tire to be correctly called the new mode of operation.

An open mind, upon thoughtfully examing the Defendant's side wall, could easily see that the side wall has been distorted from its initial cross-sectional shape and is tending towards the tire because of this distortion as first disclosed in Petitioner's patent. This is their true mode of operation and the *bridge neither exists in reality nor functions as stated.*

A REHEARING IS BEING SOUGHT FOR THE FOLLOWING REASONS

It might well be that herein lies one of the most significant points the Supreme Court will be asked to examine this term, for we have here, not the question of how the Constitution or statutes are to be applied or interpreted in a given issue, but the far more important matter of the methods by which the interpretations and adjudications are to be made. As an example: The history books one hundred years hence may devote a paragraph to whether or not a Bible was permitted to be read in a classroom, but the methods and processes used for determining that issue will be responsible for whether or not that history book is even written or that Bible printed.

Surely the manner of deciding cases as characterized by this opinion is not one readily acceptable to the Supreme Court, which is responsible for the integrity and reputation of the judiciary, for when a judicial body does not observe the basic requirements of jurisprudence, it ceases to be a court of law and becomes instead man usurping the rights of other men.

Your Petitioner is not clutching at straws in this petition. This is a deadly serious approach to an equally serious matter. Petitioner would not make claim herein made if he were not on firm ground and knew that under the facade of a just decision lies the real truth of the matter which on all the crucial matters is contra to the opinion of the Circuit Court.

Petitioner has become indebted and sacrificed much to make this appeal, it was not frivolously taken. Although Petitioner has been softened by adversity, he is not beaten into resignation by losing this one battle for there are other battlegrounds.

The patent in suit is being infringed on a national scale and Petitioner, lacking counsel or funds, is proceeding, *pro se*, to seek redress for this infringement in other circuits. Although the Sixth Circuit has erred, Petitioner retains his faith in American justice, and knows that eventually a circuit court will render a just decision concurring with the District Court in Ohio, and find the patent valid and infringed. The

Petitioner will then again attempt to obtain certiorari from the Supreme Court on the less difficult and more easily proven grounds of conflict between circuits.

The Supreme Court could expedite the conclusion of this case and save unnecessary litigation by returning it to the Circuit Court and directing that court to review this case in the light of the truths of record. But be that as it may, should the Supreme Court decide not to act on this petition, Petitioner is still selflessly concerned less the condition that produces this very inaccurate decision manifest itself in a capital case.

Perhaps the Supreme Court could encourage the Court of Appeal for the Sixth Circuit to seek some insight into its processes of arriving at opinions.

CONCLUSION

For reasons set forth above and in the petition for certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Appeals for the Sixth Circuit.

Respectfully submitted,

Petitioner

AFFIDAVIT OF PETITIONER

I hereby swear that the foregoing petition for rehearing is presented in good faith and not for delay, and is restricted to grounds specified in Rule 58 of the rules of this Court.

Petitioner